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PATENT CASES

1885-1887

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GRIFFIN





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# PATENT CASES

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DECIDED BY THE  
COMPTROLLER-GENERAL AND LAW OFFICERS  
OF THE CROWN IN 1887,

WITH A FEW DECIDED 1885-6:

*TOGETHER WITH SOME UNREPORTED CASES IN THE  
COURTS OF LAW.*

EDITED BY  
*W. H. G.*  
**RALPH GRIFFIN,**  
OF THE INNER TEMPLE, BARRISTER-AT-LAW.

LONDON:  
WATERLOW AND SONS LIMITED, PRINTERS, LONDON WALL.  
1888.

305

JAN 12 1915

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## PREFACE.

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By the kindness of the COMPTROLLER-GENERAL, and with the invaluable assistance of Mr. W. H. SPRAGUE, of the Patent Office, I have been enabled to report these cases decided by the L. O. and C. G. for the most part in 1887, but some few in the years 1885-6.

The judgments are abstracted from the notes of the shorthand writers to the Patent Office, Messrs. MARTEN & MEREDITH, of 13, New Inn, Strand, W.C., the accuracy of which can be invariably relied on.

I have, in accordance with a suggestion of the present S. G., added in every case the date at which the L. O. judgment was delivered.

It will be found, as I believe, that these cases in conjunction with those I have already reported in my Patent Cases, 1884-6, form a complete series of all cases of interest decided by the L. O. and the C. G. under the Patents Act, 1883.

I have to thank T. ASTON, Esq., Q.C., for allowing me to use and reproduce his notes of certain unreported cases of very great value decided in connection with the well-known *Bovill* patent. These will be found on pp. 45-53.

RALPH GRIFFIN.

6, CROWN OFFICE ROW, TEMPLE, E.C.

Feb. 8, 1888.

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### ABBREVIATIONS.

Goodeve P. C.	. . . .	GOODEVE'S PATENT CASES TO 1883.
Griffin P. C.	. . . .	GRIFFIN'S PATENT CASES, 1884-1886.





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# APPLICATION FOR PATENT.

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BROWN.

*Title not sufficiently describing the subject matter.—Appeal.*

Application for a patent for "improvements in casks and tubs," with a complete in the first instance, which stated that the invention was applicable to barrels or other casks and also to tubs *and analogous vessels* in which the staves are formed with a croze or groove for receiving the head or bottom; and the object of the invention was to secure the bottom or head against outward displacement, and also to support the staves beyond the croze against any force or blow delivered upon the exterior of the staves such as would tend to break off their ends projecting beyond the croze. The C. G. refused under s. 7 (1) to accept the specification unless the words "and analogous vessels" were added to the title, or omitted from the specification, on the ground that the title did not in view of the words "and analogous vessels" in the body of the specification, sufficiently indicate the subject matter of the invention.

Appeal to the L. O. (25th *May*), 1887, allowed.

WEBSTER, A. G.—I do not regard this objection as in any way a frivolous one by the Patent Office, or an objection that was not worthy of discussion, but I think that the appeal ought to be allowed. It is quite true that words "analogous vessels" occur in the body of the specification, but it must be taken in conjunction with the whole of the sentence "and also to tubs and analogous vessels in which the staves are formed with a croze or groove for receiving the head or bottom." On turning to the claims, it is plain that they are specific. They do not relate to the vessels themselves, but to a mode of fastening in the heads and bottoms of the vessels, which are composed of staves, and there is a specific direction as to the mode of construction. Under these circumstances I think that the use of the words "analogous vessels" in the body of the specification in connection with the word "tubs," and the statement as to the way in which the invention

is to be carried out is not sufficient to raise any difficulty in respect to which the Patent Office was justified in law in requiring any alteration of the title. The Patentee is entitled to frame his title in his own way provided he does not infringe the rules of the statute, and I think, having regard to the narrow nature of the claims, the present title is sufficient. It must, of course, be distinctly understood that I express no opinion as to whether if the specification comes to be litigated he can claim anything more than that which is covered by his title and claims, but he has elected to stand upon his title, and his claims being thus specific I think the title is sufficient.

Agents, *Newton & Son.*

## AMENDMENTS OF SPECIFICATIONS.

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ALLEN, 1885, No. 12,505.

*Amendment—Terms—Patent since 1883—Intention of Patentee.*

This was a patent granted to *Allen* for "The use of earthenware pipes of novel form in the place of brickwork or other material in the formation of self-flushing water closets." The specification stated—"The invention consists of pipes of earthenware of round, oval, octagonal, hexagonal, square or other required section which connect the aperture of the seat of the water closet with the main drain in a manner to make the main drain a direct receptacle for excreted matter, and the main drain will be flushed by surface water by an automatic syphon and collecting cistern as in the ordinary manner. The pipes are to be applied as follows, viz.—No. 1, a horizontal pipe, to connect the main drain and having a socketted aperture to receive end of a vertical pipe. No. 2, a vertical taper pipe, contracting from diameter at aperture of seat to socketted aperture of No. 1 pipe. No. 3, a vertical pipe of straight section, of length required to complete height to underside of seat." Drawings were attached to the specification shewing the three pipes arranged as above stated."

*Claim.*—"The use of pipes of novel form, constructed of earthenware, to form, as hereinabove stated and described, a direct connection of the water closet seat with the main drain."

*Allen* had commenced an action for infringement against *Doulton & Co.*, and had obtained liberty from the Court to apply for leave to amend his specification. The amendments asked were as follows:—(1) To omit from the title the words "*of novel form*;" (2) to insert before claim "*I do not claim as novel pipes 1, 2 and 3, respectively*;" and (3) to alter the claim to "the use of pipes of the above form constructed of earthenware," &c. (as in original claim). The reason alleged was that the patentee believed that the form of the pipes was not new at the date of his patent. The allowance of the amendment was opposed by *Doultons* and *Fowler*, the grounds of both oppositions being that the amendments would make the specification claim an invention larger than and different from that claimed by the original specification. The patentee contended that he had worded his original speci-

fication in perfect good faith and with such skill and knowledge as he possessed, but as he had not had professional assistance in the matter, he, without meaning to do so, claimed the *form* of the pipes as novel as well as claiming the use and application of them, which was all he intended and wished to claim, but the C. G. refused to allow the amendment, holding that whatever *Allen's* intention might have been when he framed his specification, he had not claimed anything but the novel form of the earthenware pipes, and therefore if he were now allowed to disclaim the novel form of the pipes, the specification would claim something not embraced by his original claim. Appeal to the L. O. (11 Nov., 1887.)

CLARKE, S. G.—I allow the amendment as proposed. I think that my business in this case is to look at the specification, to take into consideration the declaration which has been made by the patentee as to the way in which he drew it up and as to his intention, and to exercise my judgment as to what I should fairly have considered upon reading the specification he intended to claim. I find he begins by speaking of (the S. G. read the original title). I find no description anywhere of the novel form of these pipes. The pipes as described in the specification are certainly not of novel form. The first and the third are quite ordinary pipes, the second, the vertical taper pipe, was perfectly well known at the date of the patent. Then I find the claim is to (the S. G. read the original claim), and, however clumsily the specification was expressed, I think that substantially it claimed the arrangement of the pipes and not the form of the particular pipes; and I therefore think that the amendment will not enlarge the claim and will not make it a claim for a different invention, but will remove ambiguity rather than defect in the original claim. Therefore I shall allow the amendment to be made, but inasmuch as these proceedings have been rendered necessary by the misfortune (to say the least of it) of the patentee in preparing his specification in the way he did, of course I shall say nothing about costs.

*Fowler* was the patentee of "improvements in the construction of privies and water closets," 1874, No. 2,299, and *Doultons* were *Fowler's* licensees. *Fowler* asked for a condition to be imposed that neither he or any person to whom he had granted a license should be liable for anything done by him or them prior to the allowance of the amendment.

*Doultons* asked that a condition should be imposed that *Allen* should not bring any action or take any proceedings whatever against them, or any of their customers or any person or company or corporation whatsoever in respect of any such pipes as were mentioned in the specification which had already been sold or contracted to be sold, or any use already made or contracted to be made thereof whether for or in the erection or repair of self-flushing water closets or otherwise.

For the opponents it was contended that the date, 1st Jan., 1884, was not fixed by previous L. O. finally and once for all, but

could now be conveniently altered to a less remote date. The S. G. having consulted WEBSTER, A. G., gave his decision:—I have carefully considered the question whether in allowing this amendment I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the L.O. shortly after the passing of this Act, I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to the 1st Jan., 1884. An examination of these cases as reported in *Griffin, P.C.*, shows that the reason for their so doing, and in each case, whatever its date, referring back to the 1st Jan., 1884, was, that they doubted whether s. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act. No such question arises here. This patent was dated 20th Oct., 1885, and if after the amendment any action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in s. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think I could, in strictness, attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by JAMES, A.G., in the *Westinghouse* case. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I, therefore, do not think I can properly impose this condition.

Counsel, *Moulton, Q.C., Lawson, Chadwick-Healey.*

Solicitor for opponents, *J. Anderson Rose, for Boote & Edgar, Manchester.*

Solicitor for applicant, *Pattison, Wigg & Co.*

Agent for applicant, *Haseltine, Lake & Co.*

### ARNOLD, 1882, No. 635.

*Amendment—Prior application refused—No appeal made against such refusal.*

Patent for "improvements in steam boilers." Both the provisional and complete described certain improvements in the construction of the internal flues and fire-boxes of steam boilers, and also machinery for rolling the same. *Claims.*—1. The construction of flues and fire-boxes of barrel or cone-shaped rings or plates. 2. The construction and use of a machine for giving the required form to the said rings or plates as described and illustrated in the accompanying drawings. On 11th Sept., 1886, *Arnold* applied under s. 18 for leave to amend the title by altering it to "improvements in machinery for manufacturing parts of steam boilers," and to amend the specification by striking out the 1st



claim and corresponding parts of the body of the specification. The reasons were that the applicant had been advised that the title did not embrace the subject matter of claim 2 which was set out in his provisional and described in detail, and claimed in his complete; also, that the subject matter of his first claim had been in part anticipated by a patent of earlier date. There was no opposition. The C. G. refused to allow the proposed amendments, as he was of opinion that the omission from the specification of all reference to improvements in steam boilers which was the invention for which the patent was granted, would make the specification claim an invention substantially different from the invention claimed by the original specification. Appeal to the L. O.

WEBSTER, A. G. (24th *March*, 1887), said he thought the proposed amendments were such as he would allow to be made, but he gathered from the papers that *Arnold* had on the 25th *Jan.*, 1885, made a previous application for leave to amend, which had been refused by the C. G. and against which refusal there had been no appeal to the L. O. He should require to be satisfied before allowing the application that the former application for amendment was not the same as the present one, or else some satisfactory explanation of the reason of there being no appeal against the former decision of the C. G. must be given, as he could not leave the C. G. open to have the same amendment brought before him several times. Every facility should be afforded to the agent in the present application, who was not concerned in the former one, of seeing the papers of the previous application, and declarations could be put in to account for there having been no appeal in the former case and stating any substantial ground why *Arnold* was entitled to proceed with the present application. But he should require a strong case to be made out before allowing a matter which might have been the subject of appeal nearly two years ago to be re-opened.

The case was adjourned and declarations were put in in which *Arnold* declared that he was ignorant of patent law, and that he was not aware until after the C. G. had refused to allow the present amendment that he could have appealed against the former decision of the C. G. It was admitted that the present amendment was substantially the same as the former one.

The A. G. (25th *May*, 1887), said he was not satisfied that any sufficient reason existed why proceedings were not taken to question the previous decision of the C. G.

Appeal dismissed.

Agents, *Newton & Son*.

ASHWORTH, 1878, No. 3513.

*Different Invention—Broad Claim—Terms—Reasons—Costs.*

Application made to amend for the reason that the applicants desired to render the claims of their specification more clear and

precise. The patent was for "improvements in wire cards and in the preparation and treatment of wire therefor, applicable wholly or in part in the treatment of wire for some other purposes."

The invention related to cards with wire teeth projecting from them used in carding cotton. The amendments desired were only in claims 1 and 2. These claims as they originally stood are shown below in full type. The applicants desired to strike out the deleted words and insert the words in italics. *Claim.*—  
 1. The manufacture of the dents or teeth of cards from a continuous length of ~~hardened and tempered~~ steel wire *hardened and tempered in the manner substantially as set forth and indicated* hereinbefore and in and by the accompanying drawings.  
 2. Hardening the wire for cards by drawing it through a gas flame and passing it instantaneously into a bath of oil or other matter *substantially as set forth and indicated.*

There were numerous opponents. The C. G. allowed the amendments. Appeal to the L. O. dismissed (10th March, 1886).

During the argument DAVEY, S. G. said: When you claim a patent for a process, you are bound to show some way of carrying that process into effect. Then the proper claim is to the process "substantially as set forth." What "substantially" covers is a different matter. As the 2nd claim originally stood it purported to include all processes, all means, by which this result of hardening the wire was effected, and therefore the one described as well as all other processes. Now he cuts off all the other things except the one described, and confines the claim to the one described. It is not different.

As to conditions to be imposed the S. G. said:—The practice as settled by JAMES, A. G., and HERSCHEL, S. G. (*Hearson, Griff. P.C. 309*), was in cases of disclaimer not to extend protection beyond 1st Jan., 1884. I certainly should not depart from a practice so settled and approved by WEBSTER, A. G., (*Haddan infra*), or at any rate adopted by him in a case of disclaimer. It is *a fortiori* in a case of amendment. At the same time I shall always be ready to listen to special circumstances, but where there is a rule it is not to be frittered away, and they must be real circumstances.

Objection was made that the reason given was not the real reason.

The S. G.—The s. 18 (2) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request. I should be very sorry to disallow an amendment merely because I thought the reasons given for it are insufficient. I agree that those reasons are very general, and perhaps it would be desirable to put them in a more precise form. I think it is an element to be considered on the point urged that he has converted his 1st claim from a claim to the manufacture in the manner described into a claim to the manufacture of a different kind of wire.

In his judgment the S. G. said : The 1st claim as it stood, looking at it alone, without the context, and without reference to the other parts of the specification, is, in my opinion, ambiguous. It might either mean "the manufacture," "as set forth and indicated hereinbefore and in and by the accompanying drawings" "of the dents or teeth of cards from a continuous length of hardened and tempered steel wire," or it might mean "the manufacture of the dents or teeth of cards from steel wire hardened and tempered as set forth and indicated hereinbefore and in and by the accompanying drawings." If, however, I read the whole of the first claim with the context, and having regard to the fact that the accompanying drawings relate exclusively to the hardened and tempered steel wire, I come to the conclusion that the construction intended to be put upon that 1st claim was steel wire hardened and tempered in the manner set forth, and indicated hereinbefore, and in and by the accompanying drawings." I think that that is a much more satisfactory ground to go upon than what it was suggested I ought to have had, which was a statement by the patentees that that was what they meant. If I thought there was more ambiguity than I think there is when the matter is threshed out and thoroughly considered, I might have thought it a slip on the part of the patentees in making this application that they have not stated that that was their meaning ; but I have come to the conclusion, without saying the matter is entirely free from doubt, that on the true construction of the claim as it stands it was intended to relate to that. The patentee says there may be some ambiguity about it ; I wish to make that which I say is the true construction of it at present free from doubt and difficulty.

It is said that the amendment makes it substantially differ. That depends on the construction which you put upon the 1st claim, and if the 1st claim, according to its true construction, did bear the meaning which has been put upon it, namely, that it was for the manufacture of the dents or teeth of cards from a continuous length of steel wire hardened and tempered in any mode, I think that there would be great force in that argument. I have already stated my views as to that, and I think that there is a certain ambiguity upon it which requires to be cleared up ; but I also think that there is enough, when read with the context, without expressing any concluded opinion, whion I have no right to do, to justify me in allowing the amendment to be made.

Then, with regard to the 2nd claim : as it is at present it might be said to mean every mode, whether described or not, of hardening the wire for cards by drawing it through a gas flame and passing it instantaneously into a bath of oil or other matter ; and therefore would include that which is not set forth and indicated. The object of these words—whether they were necessary

or not I express no opinion upon—seems to me to be to restrict and not enlarge or make the invention different.

Then the only other point is this—what condition should be annexed to the amendment? I invited a statement of any circumstances which were supposed to arise in the present case. The only thing that has been suggested to me is that since this amendment has been allowed by the C. G. the patentees have been threatening an action. If I saw, or if there was any evidence before me that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which was claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment. But there is nothing of that kind here; and one can very well see that if on the one hand the patentee has got a patent which contains claims larger than he can support, and a patent which perhaps he is advised it would not be safe to go into Court upon without amendment, he may, for all that, have a very valuable and meritorious invention; and one would not have much sympathy for persons who were using his very meritorious invention, relying on the invalidity of the patent from some defect in the description, or from its containing claiming clauses which were larger than could be supported in Court. I, for one, should not have any sympathy with a person who had availed himself of those defects which the law has now allowed to be amended, and had infringed the real invention. If, on the other hand, they have not infringed the real invention, of course they have a good defence to the action and they need not be afraid. It seems to me to be no reason why I should deprive the patentee of the right which he has, according to what is now the settled rule in these matters, of suing in respect of matters before the amendment but after the 1st Jan., 1884, merely on the ground of the supposed hardship it would impose upon people who have not infringed the patent of having to defend a patent action.

I do not intend to give any costs of this appeal; although I have decided in the patentees' favour, I must say that people who come forward with specifications so loosely framed as this one seems to me to be—I express no concluded opinion upon it—must not be surprised if their rival traders are disposed to oppose their getting the amendment which they may be entitled to.

Counsel, *Hemming, Q.C., Romer, Q.C., Goodeve, Arnold, Loveland, Bowfield, Lachlan*, for the opponents. *Aston, Q.C., Macrory, Chadwyck-Healey* for applicants.

Agents, *Brierley, Downing*.

## BECK &amp; JUSTICE, 1877, No. 4114.

*Amendment stating knowledge acquired since the complete filed.*

Application to amend specification of patent for "improvements in nozzles for the escape of steam or gases under pressure." No opposition.

By this invention the steam was allowed to escape from a small pipe into a large chamber full of glass beads or the like, where the sound waves were broken up by being distributed among a series of small spaces. One proposed amendment (rider C) gave detailed measurements for the inlet and exit steam pipes and for the chamber and stated "for the exhaust of gas engines the size of the chamber should be based somewhat on the H. P. and rapidity of stroke." There was no mention of gas engines in the original. The C. G. declined to allow this amendment. On appeal 18th Nov., 1886, decision affirmed.

WEBSTER, A. G.—I do not think I can allow C and I will say why. Here I have to deal with a comparatively old specification. The applicant very frankly admits that a good deal of this information is necessitated by the development of the discovery of the gas engine or by gas engines being more largely used and developed. My idea of the function of an explanation within s. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge. I do not mean to lay down a hard and fast rule, but speaking broadly it was intended to permit a man to amend, correct and explain the enunciation of his invention as he intended originally to give it.

*Agent, Justice.*

## BELL, 1885, No. 1965.

*Who entitled to oppose—Ground.—Costs of prior abandoned application.*

Application (9th April, 1887) by the owners the Fusee Vesta Co. to amend. Opposition entered by Bryant and May Limited, on the grounds (1) that the amendments would make the invention substantially different, and (2) would make it the same invention as that described in specifications of 1862 No. 1382 and 1868 No. 1762. Neither of these patents belonged to the opponents.

The invention related as stated in the original specification to a combined fusee and wax match, consisting of a combination with the ordinary wax match of an inflammable composition "such as is used for fusees (but preferably with a composition the ingredients of which were given) by which the wax stem of the match is more easily ignited than by the ordinary friction head only." *Claim*—2. A cigar or pipe-lighter consisting of a length of taper composed of fibres or threads coated with paraffin wax, stearine or equivalent material,

an inflammable composition such as herein specified, and an igniter or friction head as described. The applicants proposed to insert after the passage above italicised the words "*which flame,*" and at the end of the passage cited to add "*The composition must be such as will ignite the wax stem into flame.*" They proposed to insert before the claim "*I make no claim to a fusee head upon a wax stem except the material of such fusee head and wax stem is ignited into flame by the combustion of the inflammable composition,*" and to add at the end of claim 2 the words "*the whole being such that the wax stem is ignited into flame by the combustion of the inflammable composition as hereinbefore described.*" The reason for these amendments was that the applicants were desirous of limiting the scope of the 2nd claim and making at the same time some corrections or explanations in the description. The opponents contended that whereas the fusee composition did not flame the amendments would entirely alter the scope of the invention.

It appeared that in 1886 the applicants brought an action for infringement on this patent against the opponents, and on the 14th Jan., 1887, obtained leave from KAY, J. (subject to certain terms as to costs) to apply at the Patent Office to make certain amendments in their specification which were not the same as those now sought. The applicants, however, on the 7th March applied to make the amendments identical with those now asked for. The action was discontinued prior to the 9th April, and the application to amend made on the 7th March was withdrawn on the 20th April. The opponents had incurred costs in respect of the application to amend of the 7th March, and asked that the payment of such costs by the applicants should be made a term of any amendment being now allowed.

The C. G. (6th Aug., 1887) refused to impose the term, saying that as the action was discontinued prior to the 9th April, the order of KAY, J., had no force in respect of this application, and that the applicant was entitled to apply to amend in any manner he thought fit. As to the second ground of opposition the C. G. held it was not one which it was competent for a member of the public to set up, that if the prior patentees were the opponents the ground would be tenable, but that where the opponents shew no interest in the prior patents, especially in a case where they had expired, no valid ground of opposition existed.

Appeal to the L. O. dismissed (4th Nov., 1887) with 10 guineas costs.

CLARKE, S. G.: The opponents ask me to say that I am perfectly satisfied that upon this amendment being made the patent would be for substantially the same thing as was covered by the old patents, and they ask me to say, because I am absolutely satisfied of that, that I will not allow the amendment; they agree that if I have doubt on that point it would not be unreasonable that I should leave it to be discussed in another place where it

may be discussed with great fulness and with greater authority. I am by no means prepared to say that I am absolutely satisfied on that point, but I desire to express no judgment about it. I do not think that the question so raised is one with which I have really to deal. It sounds very plausible to say that it is wrong of a L. O. to allow a patent to go in an amended form when he would not have allowed it to go in the first instance if it had been originally propounded in the amended shape. But it seems to me the question is a different one. I have to deal here with an existing patent and an application is made to amend that. The S. G. then read subs. 4 and 8 of s. 18, and added :—The objection here is not that the invention will be substantially larger or substantially different, but that although it is smaller than the original claim it still is in conflict with patents that had previously existed and which have now run out. I do not think the opponents here are in the position of persons entitled to be heard with regard to those patents." The S.G. then referred to *Glossop (Griff., P. C. 285)* & *Heath & Frost (Griff., P. C. 288)* and added :—I have nothing whatever to do with the question of the costs of proceedings that took place at an earlier time when an action was going on.

Counsel, *Bousfield ; Carpmael.*

Agents, *A. M. & W. Clark ; Wilson, Bristows & Carpmael.*

#### HADDAN, 1878, No. 2,003.

*Second disclaimer—Costs—Identification of protected articles—Date of protection.*

Application by the Anglo-American Brush Electric Light Corporation, Limited, to disclaim the 8th claim in the above patent, which was granted on communication from *Charles Brush* for "improvement in apparatus for the generation and application of electricity for lighting, plating, and other purposes." Oppositions were entered. There had been a previous disclaimer. The C. G. allowed the disclaimer.

Appeal to the L. O. (29th July, 1885) decision affirmed. In his judgment on the question of identification of protected machines WEBSTER, A. G., said :—I do not think any L. O. or C. G. can put down what are the most convenient means of identifying machines, which is all that is wanted to be done in these cases. What would be sufficient in one case would be wholly inapplicable in another. It would be much better that the parties should agree upon a form which will be applicable to their special business and submit that to the C. G. rather than to leave the language to be settled by him, especially as it is not desirable to have appeals upon the question of terms. The agreed words should be sent to the patent clerk to be embodied in the order. With regard to the date, I do not intend to deviate from the decision of my predecessors in these cases, whatever might be my first impression if I had to decide the thing for the first time. It

is very important that there should be uniformity of practice, and therefore in the absence of special circumstances I shall adhere to the decision of the late L. O. It must be understood that any party is at liberty to bring forward any special circumstances to cause the L. O. to insert a later date than *Jan. 1, 1884*.

I am particularly anxious not to encourage appeals. Under ordinary circumstances, where the parties are not successful in appealing, I shall award costs against the unsuccessful party, but this is a case of a second disclaimer, and I have always held the opinion that second disclaimers are not to be encouraged if they can possibly be avoided, and therefore, as they must be narrowly watched, I shall make no order as to costs.

Counsel, *Moulton, Q.C. ; Graham.*

Agents, *Johnson ; Brookes & Son ; Imray.*

#### HAMPTON & FACER, 1885, No. 8,981.

*Stating demerits of old process in Amendment—No evidence of demerit—Opposition by prior Patentee—New evidence before the L. O.—Reference to prior Patent—Costs.*

The specification of this patent for "improvements in the method of casting steel ingots" was filed the 24th *April*, 1886, and stated that the principal object of the invention was to cast several ingots at once, the stream of molten metal being directed to the centre of each ingot mould, so as to prevent the metal from striking the sides of the mould, whereby the production of defective ingots was avoided and the mould was less liable to be injured. The molten steel being poured into a central opening was conducted along gutters (which were shewn in the drawings with a cover over them) to holes in the centre of each mould. The advantage of the use of the cover was stated to be that it tended to exclude the atmosphere from the molten metal during its passage from the central opening to the moulds. The specification further stated that "suitable conduits, either covered or uncovered, might be employed." There were several claims, but the 1st claim was the one affected by the proposed amendments. The patentees applied to amend (1) by striking out the statement that the principal object of their invention was to cast several ingots at once; (2) by inserting a statement that no claim was made separately to the directing of the molten metal to the centre of the moulds; (3) by striking out the statement that "uncovered" conduits might be employed; (4) by inserting immediately before the claims the following statement:—"We are aware that the casting of steel ingots simultaneously through centrally situated nozzles or outlets is not new, as such simultaneous casting has been already put in practice with the aid of ladles, or open intermediate receivers held above or resting upon the moulds, and having a number of nozzles or outlets through which a number of moulds were filled simultaneously."

"The said open intermediate receivers or ladles were, however,



subject to the disadvantage that the molten metal contained therein stood exposed to the atmosphere, whereas in our apparatus the metal is not so exposed, but is covered in and protected on its way to the moulds by the cover"; and (5) by altering the 1st claim as shewn, by striking out the deleted words and inserting those in italics.

"1. In casting a number of steel ingots simultaneously and in groups directing the molten metal from a central or common gate or opening by means of *covered-in* gutters or passages to holes or inlets situated centrally over each ingot mould in the group, whereby the metal is ~~poured into~~ *led through covered passages* to the centre of each mould substantially as described and shewn."

The reasons for the application were, that the patentees had been advised that their specification did not distinguish with sufficient clearness between what was new and what was old, and that certain of the claims were capable of being construed as covering subject matter which was not new at the date of the specification.

*Melling* opposed upon the ground that if the amendments were allowed, they would have a prejudicial effect upon his rights under patent 1884, No. 13,022. *Melling's* specification, dated 25th June, 1885, described a receiver or runner, through the bottom of which four or more nozzle holes were formed to correspond in position with the centres or thereabouts of four or more compartments in the mould upon the top of which the receiver or runner was supported. The molten steel being poured from the ladle into the receiver, it would run through the nozzles and fill the compartments of the mould underneath. *Claims* :—  
1. The method of casting clusters of ingots as hereinbefore described and illustrated. 2. In casting clusters of ingots, the use of an intermediate receiver provided with nozzles for the purpose specified, and substantially as hereinbefore described and illustrated. The C. G. allowed all the amendments with the exception of the second sentence of amendment 4, as to which he said—No evidence has been filed by the applicants to show that the disadvantage which they wished to allege to exist in the use of "the said open intermediate receivers," did in reality exist; and in view of the opponents' invention to which the statement of disadvantage appears (so far as my information upon the evidence before me goes) to be specially directed, I do not think I should be justified in allowing a later patentee to state in his specification by way of an amendment, that an invention for which a prior patent existed had certain disadvantages. It would have been open to the applicants to have so stated in their original specification, but I cannot now allow such a statement to be inserted.

The applicants accepted this decision: *Melling* appealed, and thereupon the applicants applied under L. O., Rule 8, for leave to

file evidence to shew that *Melling's* invention had been in use before the date of his patent, but as they had accepted the decision *in toto*, CLARKE, S. G. refused leave.

*Melling* sought to get all No. 4 struck out or modified so as to cause a reference to be made to his patent.

He contended that as the dates of the specifications were very close, the amendment as left by the C. G., cast doubt on the novelty of his invention; and as claim 1 as amended was not a claim for casting a number of ingots simultaneously, but only a claim for a particular mode of doing it, it was not necessary for the applicants' protection to state in their specification that casting ingots simultaneously was not new.

CLARKE, S. G. (8th July, 1887).—Of course I am anxious in dealing with this matter, to be guided as far as possible by the decision of the C. G.; but I am also bound to look at it myself, and see what I think is just as between the parties and the least likely to be embarrassing and troublesome to either of them at a future time.

It seems to me that with regard to the first sentence of amendment No. 4, it ought not to be allowed to stand; for the use of the words "open . . . upon the moulds" does, in my opinion, impute to all former used or patented methods a fault which I am not satisfied existed in them. I do not think that a reference to *Melling's* patent should be insisted on. *Melling* must be left to deal with his own patent in his own way and protect it. I do not think it would be right to require in this specification any sort of acknowledgment of that patent. That must be dealt with in other ways. Then, taking it that the only thing which I think right is the disavowal of any novelty in the casting of steel ingots simultaneously through centrally situated nozzles or outlets, the question arises whether the form in which that statement is contained is the best and most useful form. I do not think it is, and I shall require the following words to be substituted for that part of amendment 4 which the C. G. allowed:—"We do not claim the casting of steel ingots simultaneously through centrally situated nozzles or outlets." That alteration will do the applicants' patent no harm, and it will put the specification in harmony with the amended claim. I am not disposed to give costs to either side. I think that, on the whole, there has been matter of reasonable discussion, as I do not entirely agree with the C. G.'s decision, but am quite satisfied that a reasonable judgment might come to a different conclusion to that at which I have arrived.

Counsel, *Goodeve* for Opponent.  
Agents, *Drury; Dutton & Fulton*.

## LAKE, 1886, No. 4,387.

*A doubtful amendment to be allowed—Costs where no opposition not given by L. O.*

*H. H. Lake* applied to amend the specification of his patent for "improvements in and relating to the manufacture of colouring matters" (a communication, &c.). The application was made under s. 18. There was no opposition.

The invention, as described and claimed in the original specification, comprised the manufacture of a new sulpho acid (diamido stilben) and the production of dyes by combining the tetrazo body obtained by diazotising the new body with one or other of a list of bodies. Examples of the process were given.

The proposed amendment comprised (*inter alia*) the insertion of the following clauses after the list of bodies :—

"This series of different colours produced according to the present invention can still be increased by mixing two of them together, a middle shade of the two being thus produced. It is a matter of course that in lieu of mixing the produced colours one may obtain a middle shade by employing, instead of two molecules of one of the said substances, only one molecule of the one and one of the other, both molecules being successively combined with the tetrazo body."

The claims were not altered in any way.

The C. G. refused, having regard to s. 18 (8), to allow the above amendments.

The applicant appealed to the L. O. who, after hearing the applicant and an examiner from the Patent Office on behalf of the C. G., allowed the appeal. (24 Nov., 1887.)

WERSTER, A. G.—Under ordinary circumstances it rests with an applicant to take the responsibility of the question whether a proposed amendment will invalidate his patent. No doubt under s. 18 (8) the L. O. is bound to see that the amendment would not make, &c. (the A. G. read to the end of s. 18 (8)) and of course if there is fairly substantial and clear evidence before the C. G. or the L. O. that the consequence of the amendment will be within the vice pointed out in that subsection he ought to decline to allow the amendment. But in any question of doubt it certainly is not the duty in my opinion of the L. O. to disallow the amendment, because he may thereby deprive the patentee of valuable rights and if the patentee persists in an amendment he persists at his peril, and if the patent is bad so much the worse for him.

The fact that the claim itself is not altered is not conclusive, because it may be that the words of the claim are large enough to include any mode of production referred to in the specification.

If one looks at the provisional the tetrazo body produced is said to be composed of one molecule of the new sulpho acid and two

molecules of nitrite, and the colouring matter is said to be formed "by bringing the tetrazo body thus produced into further reaction with the following substance," and a list is given. The example afterwards given in the provisional is one in which there are two molecules of one of the substances combined with the tetrazo body. In the first place that is put in as an example and an example in itself imports that it is not a hard and fast rule. Secondly I do not see anything beyond the example to indicate that there may not be a combination of the tetrazo body with one, two or more of the "following substances," or with more than one molecule of those substances. In the complete as originally framed the words are "by bringing the tetrazo body thus produced into further reaction with two molecules of the following substances." Those words would be read *primâ facie* to indicate two molecules of each of the following substances, but I do not know that there is anything unfair in reading the words to include reaction with a molecule of more than one of the substances. Then, again, the formation of intermediate colours by combinations would seem to be fairly within the scope of a specification which manifestly is not for any particular colour, but for a range of colours. Under these circumstances, although the matter is one certainly of difficulty having regard to the very abstruse nature of this science and the difficult nomenclature which is employed and which has to be understood in order to understand the specification, I am of opinion that this is not a case in which I can see so clearly that the amendment is contrary to the restrictions of s. 18 (8) that I can disallow it. I think it right to say that the patentee takes this amendment at his peril, and that I do not express any final opinion beyond this that upon the information before me I cannot see that it extends the grant. I shall not give any costs in this case. In fact I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the C. G. should neither give nor receive costs.

Counsel : *Wallace.*

Agents : *Haseltine, Lake & Co.*

### MORGAN, 1876, No. 2892.

*Old patent—Return of hearing fee—Description of Drawing previously undescribed.*

Application to amend specification of a patent granted (on communication, &c.) for "improved watch-keys," opposed by one *Birch*, who, however, withdrew his opposition. The C. G. refused the amendment on the ground that it would alter the nature of the invention within s. 18 (8). In the original description the applicant had mis-described one of the figs., viz. No. 3, in the sheet of drawings. He now desired to insert a proper description of it, and to add at the end of his claim "*and as illustrated in the accompanying drawings.*"

The invention related to a watch-key wherein a pair of angle jaws gripped diagonally opposite corners of the winding post of the watch, and were made to hold tight the post by a tubular case pressed down by a spring on to the diverging shanks of the jaws. The arrangement was shown in various figures. *Claim* : The improvement in watch-keys consisting of jaws having angle faces adapted to clamp the opposite diagonal corners of the winding post of a watch, and being constructed with portions above the said faces converging in the plane in which the angles of the two jaws lie, but parallel in the plane at right angles thereto and having a tube sleeve or collar to close and a spring or springs to open them substantially in the manner described.

On appeal (18th Nov. 1886) WEBSTER, A.G. said :—In an old patent like this I am very indisposed to make any alteration in the specification, but I do think that in this particular case justice does entitle the applicant to have one. Fig. 3 stood upon the complete ever since it was filed, and looking at the provisional, I am satisfied that would include it. Therefore I think I shall not be wrong in allowing the description of that drawing to be inserted. I am clear that I am not entitled to allow any extended claim, and if it was not that I think that the original claim does cover it, I should not have allowed it. I shall not allow the words “and as, &c.” (above in italics). I think “substantially in the manner described” is quite sufficient.

Application was made for a return of the stamp on the notice of appeal.

The A. G. :—This was a case in which the C. G. was quite right in declining to allow it in the first instance and to leave it to the L.O. There was quite sufficient difficulty about it. It is a ten-year-old patent, and therefore I should not be disposed to make a special order.

#### NORDENFELT, 1885, No. 8269.

##### *Extension of Grant—Ground for Amendment.*

Patent granted the 8th July 1885 for :—“improvements in the manufacture of castings from wrought iron and steel”; a complete had been left with the application, in which it was stated that it was well known that one of the great difficulties in making castings from steel was to get a product which was solid, sound, homogeneous, or free from blisters or cavities. *Nordenfelt* had found that castings of wrought iron or mild steel might be obtained solid without changing the intrinsic quality of the metal by the addition of the metal aluminium either alone or in the shape of an alloy. The aluminium made the molten metal more liquid, thus the gases in the metal passed easily away, the metal ran more easily into the moulds, and a more perfect product was obtained. He had found that even a minute quantity of metallic aluminium added to the molten iron had an appreciable influence. The iron or steel was melted in crucibles, converters, or metal-

smelting furnaces of any description, and the addition of the aluminium or alloy of aluminium was made to the metal when molten shortly before it was to be poured. *The addition might, however, be made earlier.* Claim: The admixture of metallic aluminium or aluminium alloy with the melted iron or steel before casting the same into moulds substantially as described. The applicant (27th Sept. 1886) asked for leave to amend for the reason that he wished the principle on which his invention was based to be fully understood, and proposed to omit the words shewn above in italics, and to insert the following statement before the claim:—

“The way in which aluminium so added is efficacious in producing good castings I desire to explain as follows: If, for instance, I assume the melting point of wrought iron to be 4,000°, and I heat it to that temperature exactly, it is impossible to remove it any distance from the furnace before it commences to solidify, and it is thus impossible to make a homogeneous casting. If I superheat it only a little, I may be able to carry it fluid a few feet to the moulds; but even then I cannot make a homogeneous casting. For being able to handle the metal in a practical and convenient way and pouring it into castings, particularly thin ones, it is thus evidently necessary to have the metal considerably superheated. The usual way to produce this necessary superheating is to gradually raise the temperature above the melting point, which operation is generally termed by steel melters ‘dead melting’ or ‘killing.’ Now this operation of gradually raising the temperature above the melting point is most injurious to the metal. It is during this operation that the metal takes up gases from the surrounding atmosphere. Practically speaking, no gases are absorbed when the metal is solid. It is after the melting that oxygen, nitrogen, hydrogen, and carbonic oxide are taken up, and for reducing the injury of these gases many admixtures have been used, such as ferro-manganese, silicide of manganese, &c., all of which, to a certain extent, remedy the evil, but at the same time change the nature of the metal and are objectionable in one way or another. Now it is evident that if I can superheat the metal some 300° or 400° without the aid of the furnace I give no opportunity for gases to be taken up.

“It is a well-known fact that generally alloys melt at a lower temperature than would be expected from the melting point of the ingredients. For instance, tin, bismuth and antimony melt at respectively 440°, 550°, and 700°, but an alloy of equal parts of these three metals melts at about 170°, that is, a temperature lower than boiling water. Platinum, one of the metals most difficult of fusion, melts at a brown heat if a little lead is added. Wrought iron melts at 4,000°, but if I add carbon (which cannot be melted at all) to the extent of 1 per cent., I have tool steel, which melts at about 1,000° less. I have found that the

metal aluminium has a very effective influence upon iron in this direction, and also that the addition of aluminium in sufficient quantity for my purpose has no detrimental influence upon the iron. It is of this property of aluminium that I avail myself. I heat the wrought iron just to melting, but not more; and then, as soon as the metal is molten I add a small quantity of aluminium, say from about 0.05 to 0.03 of one per cent., thereby producing a sudden lowering of the melting point, and obtaining a superheating of, say 300°, 400°, or 500°, sufficient at least to be able to handle the metal in a practical way and pour it into castings.

"To an insignificant extent gasses are, however, taken up during the melting, but they are released by the suddenly increased fluidity, due to the superheating effect which changes the consistency of the metal from something like syrup to the fluidity of water. The most convenient way in which to add the aluminium is in the shape of an alloy with iron, or rather with pig iron, whose carbon and silicon (the quantity to be used being small) are advantageous rather than otherwise."

(The claim was not altered.) There was no opposition. The C. G. refused both amendments, but on appeal to the L. O. (25th Jan., 1887), WEBSTER, A. G., allowed the words to be omitted, saying, in the course of the argument, "It is clear that that could not extend the claim. Whereas now it stands as a claim to put in the aluminium at the melting point, or earlier, the striking out of those words would limit it to the time indicated the melting point."

The A. G. refused to allow the insertion of the statement saying:—It must be remembered that this complete has been a public document for a considerable time, and that it was originally filed by the patentee in such a condition that it should have properly described the nature of the invention. I am not at all saying that in proper cases of amendment the question of whether a complete or a provisional has been originally filed makes much difference, but at the same time the fact that the complete has been filed in the first instance must not be lost sight of, and whether we are dealing with an invention in such an advanced stage that it can be described sufficiently from a patentee's point of view to warrant a complete, or with an invention requiring development and working out.

Now the amendment is sought to be justified on two grounds. It is first stated that it is desirable to put in some proportions, but the applicant does not wish to be limited to those proportions, but would prefer to insert a statement that he did not limit himself to those quantities. It would not make any difference in my decision whether the statement had been put in or not if I had been prepared to allow the amendment; I should have allowed the applicant to insert the limiting words or not as he thought desirable. The other point in respect of which the amendment

is requested is as to the character of the alloy in which the aluminium may be introduced if not introduced pure. To allow either of these amendments would be highly dangerous, and I consider that no case has been made for them. The ground is stated to be that the patentee desires the principle upon which his invention is based to be fully understood. Now if it was an invention—and for this purpose I will assume that it was—or rather a discovery that aluminium when put into the molten iron lowered the boiling point in such a way that the iron became practically superheated instantaneously or within a short space of time I think that the specification discloses a very valuable invention. I cannot, of course, tell, and I have not the least idea whether that is the true state of things or whether this is a case in which a known scientific fact or principle has been patented. If the putting in the aluminium into the molten iron or steel was the proper subject matter of an invention, and was not a mere example of a known scientific fact, as far as I can judge the specification sufficiently describes and claims the invention, but under any circumstances, whether that be so or not, it is the duty of the patentee to fulfil the condition of the patent and to file a proper and sufficient specification. Of course I am well aware that when a disclaimer is required it is because there is a defect upon the face of the specification, but in my opinion that defect must be one which must be consistent with the patentee intending to fulfil the condition of the grant by properly describing his invention, and I cannot see if that condition has been fulfilled in this case that the first amendment is required. The same observations apply to the second amendment. It is not suggested that the applicant desires to limit himself to the form of his alloy; he only indicates one or more alloys which may be used. It is stated that the invention may be carried “by the addition of the metal aluminium either alone or in the shape of an alloy.” That is in my judgment amply sufficient, assuming that the invention fulfils the conditions which I have already referred to. At any rate if it be not sufficient, I cannot see that any case has been made out for altering the specification, not on the ground that all alloys will not act, and that it has been found necessary to limit the specification because of a mistake in the statement with regard to the alloys which will act, but because the patentee desires to point out certain alloys which will work better than others, or which will be found to be convenient. It is possible—I do not in the least know—that persons may have acted upon the specification upon the faith either of its insufficiency or on the ground that it is not a publication of such an invention as should be the subject of a patent. That, of course, cannot be tried here, but, in my opinion, before the patentee can insert anything into a description which, if the invention were new was sufficient, and if not new, open to serious objection, I think he must show that there is a real reason for requiring it. The principle of his invention was in my opinion



amply described in his original complete. At any rate I am not satisfied that there is any ground in this case on which the amendment ought to be allowed.

Agent: *Carpmael*.

WALKER, 1881, No. 5645.

*Amendment—"Adjustable."*

Patent for "improvements in machinery employed for preparing and spinning cotton and other fibrous materials."

The complete stated that the object of the invention was to support the top clearing rollers, so as to prevent them from rolling off the front rollers, and to keep them always in equal contact with both rollers. The invention consisted principally in an inclined bearer or bearers (slotted or otherwise) on or against which the pivots projecting from the centre of the clearers rested.

In one part of the specification it was stated that "The said bearers may either be fixed to any hook, or they may be attached to any other fixing or part of the frame, in which case they form adjustable inclined planes."

*Claim.* The construction and application to the class of machinery referred to of an inclined bearer or bearers to support the top clearing rollers substantially as set forth.

The patentee sought by his amendment (*inter alia*) to insert the word "*adjustable*" before the term "bearer or bearers" wherever the same occurred in the description and in the claim. The C. G. refused to allow this, holding that the insertion of the word "*adjustable*" as desired, would make the specification claim an invention substantially larger than or substantially different from the original specification.

Agent: *Davies*.

## OPPOSITION TO GRANTS.

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ANDERSON & MCKINNELL, 1886, No. 3801.

*Notice of Appeal—Signature—Reference—Identical Invention.*

Application for patent for "improvements in apparatus for inducing or producing currents of air or other fluid for various purposes." The applicants employed compressed air or steam under pressure, and the apparatus was formed with an annular orifice, and so that the fluid issued in the form of an annular jet and acted with both its inner and outer surfaces on the fluid intended to be operated on. The annular orifice was at one end of an annular chamber which received the fluid under pressure by a pipe connected to it. The annular chamber was made of such a shape as to offer the least possible obstruction to the fluid passing inside and outside of it. In one modification, an annular chamber was formed by screwing together at one end, two shells, the inner one curved so that the space within it, which was open at both ends, was slightly contracted at its middle, and the outer one was similarly but reversely curved, so that the chamber was wider at its middle. This chamber received the compressed air or steam under pressure employed to produce the current by a pipe connected to a pipe flange, formed at one side of the outer shell, and an annular orifice was formed at the end of the chamber opposite to that at which the two shells were screwed together, so that the fluid issued from the chamber in the form of an annular jet, and acted with both its inner and outer surfaces on the fluid intended to be operated on.

The specification further stated that when it was desired for any purpose to make the apparatus self-regulating, as for example when the apparatus was to be used for ventilating or for producing a current of air for any purpose—the inner shell was made separate and not screwed to the outer shell, and a spring was applied between an adjustable ring or collar on the back end of the inner shell, and a shoulder on the outer shell, in a manner to give it a tendency to open the annular orifice to its widest. The inner and outer shells were shaped so that the pressure in the chamber tended to move the inner shell into a position in which the annular orifice was at its narrowest, and

the pressure acting against the spring or springs caused the orifice to become narrower in proportion as the pressure was greater, and *vice versa*. This arrangement was shown in figs. 3 and 4. *Claim* : 2. The shaping and combining of the parts of current-inducing or producing apparatus substantially in the improved manner hereinbefore described with reference to figs. 3 and 4 of the accompanying drawings. *Green* alleged that the invention had been patented 1879, No. 4536. That was a patent to one *Clark*, which *Green* owned, and the main feature of that invention was stated to consist in constructing the air jet nozzle with an automatic valve arranged to govern its discharge aperture, and loaded to open at a certain pressure, so that the jet was discharged uniformly at that pressure, and should the supply to the jet decrease in volume the valve would partly close to correspondingly reduce the area of the discharge aperture, and thus maintain the uniform pressure and velocity of the jet ; and should the volume increase the valve would open wider, thus discharging a jet of greater volume at practically the same pressure, thus maintaining the efficiency of the jet under a varying supply, causing the volume of the induced current to increase proportionately as the volume of the inducing jet increased. *Claim* : An injector nozzle for producing blasts or currents of air, constructed with an automatic valve, arranged to govern its discharge aperture and adjustable by spring or weights to open and discharge the jet at a certain determined pressure, whereby the pressure and velocity of the jet is maintained practically uniform under varying volumes, and its efficiency thus rendered constant and proportional to the volume supplied substantially as herein set forth.

The C. G. allowed the patent. On appeal (21st July, 1887,) preliminary objections were taken by the applicants—(1) that they had received no notice of appeal under L. O. r. 3, but CLARKE, S.G. held that that rule only applied when the *applicant* appealed ; (2) that the notice of appeal had not been signed by the appellant, but his agent on his behalf. The S. G. : As the notice of appeal has been signed by the agent who is authorized by the appellant, I do not think there is anything in the objection unless there is reason to think that the agent was not entitled to sign for the appellant.

The appellant asked that a disclaiming reference to his patent should be inserted in the applicant's specification.

The S. G. : I think that in this case, upon full consideration of it, it is my duty to uphold the decision of the C. G. It does not appear to be denied that there are differences, and substantial differences, in the arrangement of the parts of these two machines. It is said, on behalf of the appellant, that the changes which have been made by *Anderson & McKinnell* will either produce no result at all, or will produce a result which will positively be detrimental to the usefulness of the machine. Well, I am not at

all satisfied of that. It appears to me that they are not only different machines, but actually opposite in construction and in results as intended: in these circumstances I do not feel disposed to make any alteration in the C. G.'s decision. I should only like to add that of all ways of protecting pre-existing arrangements in matters of this kind, the one I should be the least willing to adopt would be the mention in one specification of the fact of another patent being in existence. I do not think that a very satisfactory way of protecting the rights of a former patentee, but in substance I think the C. G.'s decision in this matter was right, and I shall therefore decide in favour of the respondents on this appeal, with costs.

Counsel: *Wallace*, for opponent.

Agents: *Day*; *Brookes & Son*.

#### ANDERTON, 1885, No. 1840.

*Construction of complete agreed and placed on record—Costs—Right to cross-examine—  
Fulllest good faith in declarations—Statement not quite candid.*

Application for a patent for "improvements in cap spinning and twisting frames," opposed by Messrs. *Blackburn* on the ground that the invention had been obtained from them. The C. G. allowed the patent. Appeal to L. O. (Nov. 2nd, 1886) dismissed. By this invention the driving cylinder was mounted so as to obtain a uniform tension on the spindle driving bands in all positions, though the height between the cylinder and the wharls on the spindles was constantly varying. The cylinder journals were mounted in curved slots in brackets, and by means of excentrics the journals were caused to move backwards and forwards in the slots. The opponents had a patent, 1885, No. 3606, for the same purpose, but the motion of the cylinder in that was permissive.

WEBSTER, A. G.: I think the motion described in the complete fairly construed (and I have to construe it for myself) means only the positive motion described in the provisional, and does not mean free or permitted motion described in *Blackburn's* specification. I have considered whether I might put in the words "causing the cylinder to move backwards and forwards," but they appear in the provisional, and I do not think I can be certain that any kind of expression I can use is more likely to be correct than the construction I myself put on the words as they stand, and I prefer of course, if possible, not to alter the specification. I shall therefore allow the patent, placing it upon record that I understand by the statement and agreement of both counsel before me that all the modes described in the complete are modes of actually moving backwards and forwards the cylinder by positive motion.

I make costs follow the event in appeals if I possibly can. It is only a right thing. But it is exceedingly important, especially

before the C. G., who cannot cross-examine witnesses, that there should be the fullest good faith in the statements that are made. I am imputing to the applicant no desire to conceal; but when I have to consider what the opponents had before them, I must take him as responsible for all the consequences of his acts. The A. G. then pointed out a statement in the applicant's declaration which he considered did not quite give the whole story, and continued—I shall not under the circumstances allow him any costs, because it does seem to me that, having regard to the language of the complete, the opponents were entitled to cross-examine the applicant upon the question of what was meant by that statement in the declaration.

Counsel: *Bousfield; Aston, Q.C., Chadwyck Healey.*  
 Agents: *Waugh & Chapman; Walsh.*

### DAVID & WOODLEY, 1884, No. 13,873.

*Workman and Master.*

Application for patent for "improvements in sewing machines," opposed by *Jones* on the ground that the invention had been obtained from him. It appeared that *Jones* having invented some improvements in sewing machines, was introduced by *David* to *Woodley*, and *Woodley* was employed by *Jones* or by *Jones* and *David* conjointly (*David* claiming some interest in *Jones'* invention) to make a model. *Woodley* made some suggestions which were embodied in the model. *Jones* took out a patent for the machine, and *David* and *Woodley* now applied for a patent for the suggestions made by *Woodley*. *David* and *Woodley* had also applied, 1885, No. 2734, for a patent for alleged improvements on this invention. The case was heard by the C. G. who refused the grant, and on appeal his decision was affirmed by DAVEY, S.G., who after hearing for several days evidence *viva voce*, and taking time to consider, delivered an elaborate written judgment dealing with the facts of the case (June 20, 1886).

The S.G.: This appeal has occasioned me much anxiety and doubt as to the course which I ought to adopt. But having again read through the notes of the oral evidence given before me and the declarations, and having carefully studied the specifications in question, I have formed a clear opinion on the matter, and I think I ought not to shrink from performing the duty which the Act of Parliament has imposed upon the L.O., although the parties will be bound by my judgment without appeal. I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer and the workman cannot afterwards take out a patent for them. But then it is said that

*Woodley* was in the employment of *Jones* and *David* and not of *Jones* alone; but if the fact were so the invention was *Jones'*, and so far as I can see he had never parted with his property in it, and *Woodley* stood to *Jones* in the relation of paid servant to employer. If *David* has any claims against *Jones*, either founded on the alleged partnership or of a pecuniary character, he can enforce them in a Court of Law, and nothing that is decided here will prejudice him. The application 1885 No. 2734 is not before me, and I can make no order in that matter; but if an application is made to the C. G. to amend the specifications (provisional and complete) by striking out the reference to the previous application and substituting proper words of description of the class of sewing machines to which the invention is intended to be applied, I think it should be acceded to.

Counsel : *Aston, Q.C.* ; *Moulton, Q.C.*

Agents : *Barlow* ; *Lloyd Wise*.

#### EVERITT, 1886, No. 8403.

*Provisional stating a principle.—Complete only claiming special mechanism.—Same invention.*

Application with provisional for a patent for "an apparatus for the delivery of a given quantity of liquid in exchange for an equivalent in coin or the like." The provisional stated that the inventor adapted to any suitable measuring tap an arrangement whereby in its normal condition the tap was locked, but on insertion of the coin the tap was unlocked and delivered a definite quantity of liquid, the tap automatically closing when that definite quantity had run out. The complete described special apparatus and claimed : 1. The combination with a suitably constructed measuring tap of mechanism *such as is herein described and illustrated in the accompanying drawings*, whereby a fixed quantity of liquid can be obtained on the insertion in a receptacle provided for the purpose of a proper coin. The C. G. refused to accept the complete, saying that the invention described in the provisional was apparently for the principle of obtaining automatically a given quantity of liquid on the insertion of the coin, while the invention in the complete was not the general principle but simply special means for carrying the principle into effect, and as these means were in no way described in the provisional they could not be allowed in the complete by themselves. It was suggested that the applicant should add a further claim in the words of claim 1, leaving out the words in italics. The applicant appealed to the L. O., who after hearing (*July 6, 1887*) *ASTON, Q.C.*, for the applicant, and an Examiner from the Patent Office, on behalf of the C. G., allowed the appeal.

*WEBSTER, A. G.* : The sole question before me is one of law as to whether or not this complete can be rejected. As far as I can tell from the complete it is in accordance with the Act, Sec. 5 requires that the provisional should describe the nature of the

invention. I am clear that this specification does describe the nature of the invention, and the only criticism that can be made on the complete is that it narrows the ambit of the provisional and does not enlarge it. With regard to the case cited on behalf of the office (*United Telephone Co., v. Harrison. Goodeve, P. C., 472*) that has no application, because there it was decided that as a matter of fact the phonograph on which FRV, J., invalidated the patent had been inserted in the complete and was not fairly covered by the provisional, therefore it was a distinct case of extension of the grant and not of cutting it down. With regard to the objection that persons may see complete specifications of other applicants after filing the provisional it is undoubtedly true, but it must be distinctly understood that I do not decide this case on a question of fact at all. If in any case it was brought before me that the person filing the complete had access to other persons' inventions, or had made use of other persons' specifications or had made use of any invention derived from another source not his own, I should of course not allow the complete, but in this case there is no opponent other than the office. Such a question when it arises must be dealt with as one of fact, and I should not seal the patent if it should turn out that such an impropriety (there is none suggested here) had been committed by the applicant. Of course I can express no opinion as to whether or not this patent will be valid. All I can say is I am clearly of opinion that this is not a case in which the ss. of the Act are infringed upon.

Agent: G. F. Redfern.

### EVERITT, 1886, No. 10,680.

*Opposition on Patent ante-dated under s. 103.*

Application (20th Aug., 1886) for a patent for "automatic apparatus for subjecting the person to the action of electric currents." Notice of opposition was given (25th July, 1887) by *L'Oiseau & Pierrard* on the ground that the invention had been patented by them on an application of prior date, viz.: 1886, No. 12,833. The facts as to No. 12,833 appear below, under *L'Oiseau & Pierrard*. Their application was made the 8th Oct., 1886, but the A.G. ordered their patent to be dated 18th Aug., the date of their patent in France, under s. 103. The applicant urged that the opponent had no *locus standi*, and the C. G. (23rd Dec., 1887) without going into the merits so decided.

The C. G.: The point raised is an extremely difficult one, but after careful consideration I am of opinion that at the date of filing the notice of opposition in this case, the application of *L'Oiseau & Pierrard* therein referred to was not an application of prior date to *Everitt's*.

Appeal to the L. O. dismissed with costs (17th Jan., 1888).

WEBSTER, A. G.: Whether by accident or by deliberate design, it seems to me that the framers of s. 11 have limited the grounds

of opposition to certain specified cases; and it must also be remembered the right to oppose is a statutory right and does not exist at Common Law. I am of opinion that the only persons who can oppose under these words "patented, &c," are persons who have made an application in the U. K. of prior date to the date of the applicant's patent. It is said that that will not give full effect to s. 103, and that the date of the French application, (which date I fully recognised, and on which I felt constrained in my previous judgment to antedate *L'Oiseau & Pierrard's* rights), must also be taken as being the date of the application in England for the purposes of all proceedings under the English Patent Law. Now it is quite true that s. 103 (3) states that application must be made in the same manner as an ordinary application under this Act, and it is necessary, in order that the procedure may be applied to it. On the other hand, it is quite clear that the application in the foreign country, and the application in England, are not the same things. In the first place, to hold them to be the same for the purposes of the statute would stultify the enactment of subs. 1; but in addition on the face of subs. 1, it is clear that the application in England must be made within seven months, or may be made within seven months after the application in the foreign country. Therefore we have got this state of things: that you can have a completely valid and effective English patent, and seven months may elapse before the application may be made, founded on the foreign application of earlier date, and the later applicant may be entitled to have a good patent sealed which will override the English patent, though granted and sealed prior to the application under s. 103. A consideration of these matters forces me to the opinion that, although the foreign applicant gets most valuable rights, he does not get the right of opposing a later patent. I only wish to add that there seems to me very good reason for it. I think there is one reason that has been pointed out, namely, possible flaws in the foreign application. That is one reason why, although most important rights are given under the Convention, still, at the same time, it is not necessary there should be a right of opposition. It is said I shall virtually be giving no effect to Art. 4 of the Convention. I think I give the fullest effect to it, because I recognise its validity by ante-dating the opponents' patent to Aug. 18th. I wish to point out that if I were to entertain any opposition on the merits which went to the whole subject matter described in the specification of the earlier applicant, it would be my duty to decline to seal his patent, and I should be obliged and forced by the very reasoning urged by opponents in this case, if I admitted them to oppose, to excise from the specification the whole of *Everitt's* invention. I believe, from my recollection of this case, there is more, or it is said there is more in *Everitt's* specification than was



covered by the French application of the opponents; but—even if it is so—there may be many cases where a later patent might cover only the same ground. The result would be this—that a decision allowing *locus standi* to oppose would involve this right and this duty both on the C. G. and the L. O. If the ground of the invention comprised in this specification was found to be entirely covered by *L'Oiseau & Pierrard*, I should have felt it my duty to have stopped this patent altogether, and then something might happen which would show that my opinion was wrong, and *Everitt* would have no remedy. But it is always satisfactory to the L. O. to know, as I know in this case, that I do no injustice to the opponents. They are in the fortunate position, if my judgment is right, as I hope and believe it is, of having a patent of 18th Aug., and they will be able to set that up in opposition to *Everitt's*, and also it is open to either party to proceed by petition of revocation if they think they can make out a case.

Counsel : *Griffin*, for applicants.

Agents : *G. F. Redfern & Co.*; *Abel & Imray*.

### FLETCHER, 1886, No. 13,598.

*Patent of prior date—Similarity of inventions.*

This invention was of “improvements in dyeing tissue and other papers and in apparatus therefor;” the specification stated that hitherto coloured tissue papers had been manufactured by mixing the dye or colouring matter with the pulp and then manufacturing the paper from the pulp thus previously dyed or coloured. By this method of manufacture a considerable portion of the dye was entirely lost, and the colours were pale and deficient in brilliancy. The object of this invention was to avoid those disadvantages, and it was proposed to accomplish it by dyeing the paper (*after manufacture*) by the aid of pressure which forced the dye or colouring matter through every fibre of the paper. The method for effecting this, consisted (*inter alia*) in passing paper from a roll, first between a pressure roller and an endless felt band saturated with colour, which transferred the colour to the paper at the same time that it supported it, and the pressure of the roller forced the dye through the fibre of the paper.

The paper was then carried on (still supported by the endless felt) through a second pair of pressure rollers which squeezed out the superfluous dye and partly dried the paper. Beneath this second pair of squeezing rollers was placed a trough for receiving the superfluous colour pressed out by these rollers, from which it ran down a pipe into a tank, from which it could be raised by a pump into the cistern which supplied the colour box, and thus the dye could be used over and over again and none of it was wasted. *Claims*: 1. The method of dyeing tissue and

other papers after manufacture by pressing the dye or colouring matter through the same by means of a pair of pressure rollers at the same time that it is supported by an endless felt or cloth [*previously charged with the dye*] passing round the lower roller. 2. The construction and combination of apparatus for effecting this object substantially as described and illustrated.

*Beck* opposed upon the ground that the invention had been previously patented, 1884, No. 372; that invention was stated in its specification to consist in colouring paper by passing the same through a suitable colouring bath in such manner that the paper was equally saturated with colouring matter and subsequently drying the same. This was done by feeding the paper to be coloured from a roll, over a tension roller and under another roller which rotated in the colour reservoir. After leaving the colour reservoir the paper passed over another tension roller and between pressure rollers, and in order to remove any superfluous colour from the surface of the paper, the same was led over a felt or cloth band which ran over certain tension and guide rollers, on to which band the paper was pressed by the pressure of a pressure roller and thus all superfluous colour pressed out. The colour so expressed flowed into a reservoir, where it was collected for future use. *Claim*; 1. The process of colouring paper by passing the said paper through a bath of colouring fluid in such manner that the said paper is saturated or partly saturated with the said colouring fluid substantially as described. *Claims* 2-5 claimed the apparatus.

The C. G. allowed the patent, and on appeal to the L.O. decision affirmed (*Aug. 8, 1887*).

CLARKE, S.G.: I agree with the C.G. that this is a different invention, and I think a very useful and clever one, and I shall therefore support the C. G.'s decision. At the same time, while the words are before counsel I think he might possibly consider whether his position might not be improved by some modification of the words of the first claim. It appears to me, I am bound to say, that those words are not very happily chosen to express the distinctive characteristic of the applicant's invention, and I am surprised that there is not in those words some reference to the fact that the endless felt or cloth has already been loaded with the colour and that the paper is to take it from the felt or cloth.

Mr. MOULTON suggested the insertion of the words shown above in italics. The S. G. allowed that amendment to be made, saying: At the same time it is not any substantial alteration, and in substance I agree with the C. G.'s decision, and so I shall decide that I uphold it and give costs as if no such modification of the claim had been accepted.

Counsel: *Moulton, Q.C.*

Agents: *G. Davies; Thompson & Boul.*

## HOOKHAM, 1886, No. 3778.

*Entitled to be heard.--Disclaimer where prior invention included in provisional.*

HOOKHAM (17th *March*) applied for a patent for improvements in or additions to the india rubber tyres of velocipedes and other wheeled vehicles, leaving a provisional. On the 22nd *April* an examiner reported that the provisional appeared to him to comprise the same invention as was comprised in the specifications accompanying prior applications *Barrett & Varley* 1885, No. 4812, and *Munro*, 1886, No. 2508. *Hookham* left his complete on the 18th *Dec.*, and in it he did not describe or claim a large part of the invention described in his provisional, but he did not insert any formal disclaimer. *Barrett & Varley* entered opposition (1) on the ground of the prior patents, 1885, No. 4812, and 1886, No. 2508 and also (2) on the ground of such report. *Munro* did not oppose. The C. G. decided that certain portions, including figs. 1 and 2, were to be struck out as describing and claiming *Munro's* invention, and that a formal disclaimer should be inserted of *Barrett & Varley's* invention. The applicant appealed to the L. O., and took objection to the opponents being heard on *Munro's* specification, as they were not interested in it. The opponents urged that as they were manufacturers they were interested in the question, as if two patents were allowed for the same invention they would be hindered in their business and liable to attack by both patentees.

WEBSTER, A. G.: I think—and I speak with very great deference—there was a misapprehension in the mind of the C. G. as to what figs. 1 and 2 really describe. In my opinion the object and purpose of figs. 1 and 2 are different—assuming them to be properly described and claimed—from that which was in *Munro's* specification; and further than that, I think it was evident to the persons who drew this specification that they had certain specific improvements—whether the subject of a patent I do not of course stop to consider—which might fairly be included.

With regard to the point of law, I do not know that it is necessary for me to give a decision upon it; but I think that, as the point has been raised, I may as well say that I should concur in the principle laid down in *Glossop's* case (*Griffin, P. C.* 285), and I should not allow any person who merely comes forward as one of the public to claim to strike out certain paragraphs of a specification on the ground that it was included in a prior patent in which he had no interest. It may be the C. G. would have some power to do such a thing if the patent was obviously bad, but I speak of what I may call the special rights of an opponent to adopt that course. It is to be noted that Lord *HERSCHELL* puts it on a very narrow ground indeed, not that the opponent was one of the public manufacturing under an expired patent, but that he had had an interest in that very patent, and had manu-

factured under it, and therefore was in the nature to a certain extent, of an owner of the patent on which the opposition was founded. I think the decision of the present S. G. in *Heath & Frost's* case (*Griffin, P. C.*, 288), practically proceeds on the same lines, and in the absence of special circumstances I certainly should decline to allow an opponent a sort of roving commission to amend specifications, if there was sufficient difference to justify the subsequent patent. Therefore, so far as the striking out of figures 1 and 2 are concerned, I shall reverse the Comptroller's decision.

There remains the point as to the reference to *Barrett & Varley*, which has been, I think, very properly conceded. I desire, however, to say this, that even if that concession had not been made, as the matter has been argued before me now, if I should find that there was a distinct reference in a provisional to an invention, or a device which was within the specification of the opponent properly construed, I am not at all prepared to say that he may not be entitled to have a disclaimer on the face of the specification. I do not decide that finally, because it may be necessary to hear argument upon it further, but it seems to me there may be very good grounds for suggesting he should disclaim. We know there are reasons for it. Some judges have taken one view and some another as to the extent to which a provisional may be referred to, and it is impossible to say that a provisional may have no bearing on the construction put on a claim. Therefore, on that ground, I should have been disposed to have allowed the reference to *Barrett & Varley's*, even if it had not been conceded.

The parties have not succeeded entirely on either side, and I, therefore, shall not allow any costs of this appeal.

Counsel : *Moulton, Q.C. ; Griffin.*

Agents : *Whiteman ; G. F. Redfern.*

### JONES,\* 1885, No. 5237.

*Notice of opposition—Substantially—Identity—State of knowledge—Subject matter—Disclaimer.*

*Jones* applied for a patent for "the more efficiently fastening the frames of writing slates." *Dixon* opposed on the ground that the invention was the same or substantially the same as the invention patented by him, 1881, No. 990.

The C. G. decided that it was doubtful whether the invention

\* In this case a note of the S. G.'s judgment was issued by inadvertence before it was revised by him. Such unrevised judgment contained a statement that in the S. G.'s opinion he had no jurisdiction to determine whether *Jones'* method of fastening the frames of slates was or was not a colourable imitation of *Dixon's*. This statement was struck out in the revised judgment. I have Sir HORACE DAVEN's authority for saying that he had formed no concluded opinion on this point, and as it was not necessary to decide it he wished to leave the point open for discussion when it should arise for decision. This explanation is rendered necessary by a note in *Engineering*, Vol. 41, p. 299.

could be considered the same and allowed a patent to be sealed, *Jones* inserting a disclaimer of anything covered by *Dixon's* patent. Both parties appealed to the L. O. It appeared that *Dixon* showed in his figure five pieces of metal, like a carpenter's square, put one at each corner of the slate frame as a tenon. The metal came to the edge of the frame and was fixed in mortices in the wood and held by pins at right angles to the plane of the slate.

*Claim 3.* The improved method herein described of fastening together the parts forming the frames of writing slates by the employment of concealed "false tenons" (or corner connexions) for the purpose of superseding the usual wooden tenons substantially as hereinbefore described and represented in Fig. 5 of the accompanying drawing.

*Jones* put a thin metal L piece like an angle iron into a saw-cut in the wood perpendicular to the plane of the slate half way between the edge of the slate and the edge of the frame and secured them by pins perpendicular to the edge. *Claim :* The mode of fastening frames of writing slates by the insertion of bent pieces of metal fitted into saw-cuts at each corner of the frame substantially as described.

DAVEY, S. G., during the argument, indicated that the notice of opposition was wrong in inserting the words in italics and said : You are not entitled to show that *Jones' patent* is bad subject matter. I have no jurisdiction to decide that question. I am not entitled to express an opinion as to whether *Mr. Jones' patent* is novel or even whether it is an infringement of yours unless you can show me that it is the same invention, I mean identical. It may be a matter not of great difficulty to say whether the second invention is or is not an infringement of the first, but the danger of my deciding that is this—there is no appeal from me. It would be very hard on a patentee that he should be bound by the decision of a L. O. without appeal on a question which may be a question of considerable nicety, although I might have a very strong opinion about it. I am sure the opponent would not like to be bound by my decision on the question whether the second invention was or was not an infringement. You are really on the question of infringement when you say it is substantially the same.

Certain specifications of prior date to *Dixon's* were referred to in declarations made in the matter, and the opponent objected to these being admitted in evidence.

The S. G.—You must first find out what *Dixon's* invention is, and for the purpose of finding out what *Dixon's* invention is, of course, I can read his specification and understand it, but for the purpose of ascertaining what his invention is it is extremely material to know the state of knowledge upon the question of securing the frames of slates prior to and at the date of his patent.

Eventually both appeals were dismissed without costs.

The S. G.—I should observe that it is not for me to say whether the 3rd claim of *Dixon's* specification is proper subject matter for a patent, or whether *Jones's* alleged invention is proper subject matter. I have no jurisdiction in this appeal to do so. What I have to consider is whether *Jones's* alleged invention has or has not already been patented in this country, and if I have any doubt about it I ought to allow the patent to be sealed so that the applicant may obtain the opinion of a Court of Law. Looking at *Dixon's* third claim and his fig. 5 and his description, I cannot say that it is not at least a fairly arguable point that all he intended to claim was a tenon inserted and used in the same plane with the slate, and if so *Jones's* alleged invention is not patented by *Dixon*. I shall not interfere with the C. G.'s decision requiring words to be inserted disclaiming *Dixon's* patent.

Counsel: *Aston, Q.C.*, for opponent.

Agents: *Thomas*, for applicant; *G. F. Redfern*, for opponent.

### KNIGHT, 1886, No. 15,580.

*Appeal abandoned—Costs.*

*Knight* applied for a patent, and the grant was opposed. The C. G. ordered certain amendments to be made in the specification.

15th Sept. 1887 *Knight* gave notice of appeal to the L. O., and the L. O. clerk (17th Nov.) sent out notice of hearing for the 24th Nov. On the 22nd Nov. *Knight* sent to the L. O. clerk notice that the appeal was withdrawn. Thereupon the respondents wrote to the L. O. clerk asking the L. O. to make an order for costs against *Knight*. The L. O. directed *Knight* to send written reasons why no order should be made. *Knight* did so, but the L. O. under the circumstances made an order for *Knight* to pay costs.

Agent: *G. F. Redfern* for opponents.

### LAKE, 1886, No. 8642.

*Amendment of Notice of Opposition.*

In this case the complete was accepted on the 5th April, 1887, and on the 4th June, 1887, a notice of opposition was left at the Patent Office, beginning, "I, *Thomas Wrigley*, 36, High Holborn, London, W.C., hereby give notice of my intention," &c., and signed "*Thomas Wrigley*, 36, High Holborn, W.C., agent to opponent."

The grounds of opposition were prior patents of one *Black*, and notice of interference with a prior patent of *Black*.

Hearing of the opposition was fixed for 28th Sept., 1887, when an agent for *Black* appeared, stating *Wrigley* was dead, and that *Black* was the real opponent, and asking for an adjournment, which was granted on payment of costs. At the adjourned

hearing, counsel on behalf of *Black* applied to amend the notice of opposition under r. 18. This the C. G. allowed to be done, notwithstanding objection on the part of the applicant. The notice was thereupon amended by striking out *Wrigley's* name where it appeared and substituting *Black's*, and *Black* signed the notice. The hearing then proceeded, and the C. G. gave a decision with which the opponent not being satisfied appealed to the L. O. Appeal dismissed with costs. The preliminary objection to the notice of opposition was mentioned by the applicant's counsel, but not pressed.

Counsel : *Moulton, Q.C., Wallace ; Goodeve.*  
Agents : *Haseltine, Lake & Co. ; Myall.*

### L'OISEAU & PIERRARD, 1886, No. 12,833.

*Opposition on complete accepted—No Patent sealed—s. 15—Right of Foreign Patentee under s. 103.*

On the 8th October, 1886, *L'Oiseau & Pierrard* left an application, in the common form, at the Patent Office, with a provisional for "automatic apparatus for subjecting the person to the action of electric currents."

They left a complete, 29th Jan., 1887, which was accepted 28th March.

*Everitt*, on the 20th Aug., 1886 (10,680), applied for a patent "improvements in completing electric currents," leaving a provisional. *Everitt* left a complete on 3rd March, 1887, which was accepted on 27th May, 1887. On the 28th May he gave notice of opposition to the grant of a patent to *L'Oiseau & Pierrard*, on the ground that the invention had been patented on his application of prior date.

At the hearing, on the 26th July, 1887, before the C. G., objection was taken that as no patent had been granted at that time on 10,680, *Everitt* had no *locus standi*, but the C. G. overruled the objection, holding that under s. 15, *Everitt* was to be treated as having a patent.

No evidence had been filed by the applicants and on the preliminary objection being overruled, an adjournment was offered to them on paying the costs of the day. This they declined, and argued that on the face of the documents, the inventions were not the same. They further desired to call attention to a patent granted to them in France for the same invention, on the 18th Aug., 1886, arguing that under s. 103 and the Convention, their patent would be dated 18th Aug., and, therefore, would be prior to *Everitt's*. The C. G. held that as the French patent was not in evidence, he could not notice it, and required the applicants to amend their specification. The applicants appealed to the L. O., and renewed their objection to the opponent's *locus standi*.

WEBSTER, A.G., overruled the objection, and said:—I am

clearly of opinion that *Everitt* is entitled to oppose. I am satisfied that, in order to give any effect to s.15, where a person has had a complete specification accepted, he is intended to be in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose. In fact, the proviso preventing him from taking proceedings for infringement, accentuates and makes clear that position; because a limit has been put upon his rights of bringing actions for infringement, which limit would only be necessary if he were in the *quasi* position of a patentee.

The applicants then applied for leave to file evidence which the L. O. allowed them to do on paying all the costs. It appeared that no notice had been given at the Patent Office of the French patent and that the C. G. had not been informed of its existence till the hearing before him. The English specification contained claims of inventions not described in the French specification and the applicants asked to strike out the claim applicable to so much as was not described in the French specification leaving, however, the description of the new portion, and they tendered a specification so altered in red ink. This amendment the A. G. allowed them to make, and directed the patent to be sealed as of the 18th Aug., 1886.

(Dec. 7, 1887). The A. G.: This is a case of the greatest difficulty and I sincerely wish that I could have seen my way by some means to preserve the rights of the parties without deciding the question one way or the other, or to have so dated these patents that a superior court before whom the question could be raised should decide it. I do not know whether it may be possible that such a question could be raised on a petition for revocation; all I can say is that if there is any opportunity of raising it, and the parties wish to do so, I should as far as any consent of mine is concerned be prepared to assist them. But it is better perhaps, as the responsibility rests with me, that I should decide it on the footing of being (as I suppose) the only tribunal at present existing that can deal with it. I had better state the facts raising the difficulty as simply as possible. It appears that upon the 8th Oct., 1886, *L'Oiseau & Pierrard* applied for a patent and lodged a provisional, which did, I find, in substance (and I think I ought to say in all substantial matters) correspond identically with the French patent. It is possible on critical examination and assuming a certain construction to be put on the English provisional the opponent may be right in saying that there are minor matters of departure. But the parties in this case have by the agreed translation, enabled me to judge of the substantial identity of the invention. And I find as a fact, that the application which was made by *L'Oiseau & Pierrard*, was as to the nature of the invention therein referred to (following the language of the section with regard to provisionals) the same as that invention which is described in the French specification.



Prior to that, on *August* 20th, 1886, *Everitt* had applied for a patent for "improvements in completing electric currents," and on the information before me I will assume—and there is nothing to show to the contrary—that *Everitt* was entitled to claim in his provisional and in his complete, apparatus which would cover the invention which was the subject of the previous application in France. It has not been suggested that there has been any misconduct on the one side or the other.

It is certainly very much to be regretted that whatever may have been the real rights of the parties, *L'Oiseau & Pierrard* did not make it appear upon the face of their application that the application was in respect of an invention that had previously been patented in France. Beyond the statement that the two gentlemen reside in Paris, there is nothing to indicate that it was anything more than an ordinary application, and a very considerable time elapsed, until the month of *July*, 1887, before it was in substance brought to the notice of the opponent, and he says that must be taken as the earliest date at which rights were asserted on the basis of a prior French patent. I will assume it for the purpose of my judgment.

Now, if this case were to be decided upon equitable principles, I should have been very much impressed indeed by the argument urged that I ought in some way to protect *Everitt's* rights. And if I had felt that I had jurisdiction to protect his rights in the sense of either post-dating the patent of *L'Oiseau & Pierrard*, or of imposing terms which would have indemnified *Everitt* for any loss he might now or afterwards prove he had sustained by reason of that which certainly was not his fault, I should have endeavoured to do so. But for reasons which I will state in a few moments, I am afraid that I have no jurisdiction to take either of these courses.

Now, have I any power to deal with this matter? I think (and I wish to reserve this point) that if it were shown that the Patent Office had been misled, and the opponents had been misled, by any positive misrepresentation, or if there were anything which would amount to want of good faith, I should like to consider on another occasion whether an applicant who claims the benefit of s. 103 is entitled to receive it. But once given that there has been a *bonâ fide* application within the period prescribed by statute, and no conduct which would amount to a breach of good faith, or a breach which would prevent a man from being entitled to claim his rights, I am afraid that the words of the statute are so distinct that I have no alternative in the matter.

The statute says (The A. G. read sec. 103 (1).) I must point out that the section contemplates conflicting rights, because it uses the words "in priority to other applications," and also states in effect, that one of the rights is to have the patent ante-dated to the date of the application in such foreign State. That this is not a provision which has been inserted without due care, is clear

from the fact that s. 103, in which the words were originally "protection obtained," was amended by the Act passed at the instigation of Lord HERSCHELL in 1885, by the substitution of the word "application" for the words "protection obtained."

Under those circumstances, I, with very great regret as far as *Everitt* is concerned, am forced to come to the conclusion that I cannot, having regard to the terms of the statute, do otherwise on the facts than order *L'Oiseau & Pierrard's* patent to be dated as of the date of the application for the French patent. I cannot see anything amounting to breach of faith, or such misconduct as would disentitle them to be treated as *bonâ fide* applicants, and if I once come to that conclusion the consequences must follow.

Then it has been said that this hearing can be treated as an application for an amendment, and that I can impose terms; I am afraid I cannot take that view of this case. The jurisdiction which the L.O. exercises of imposing terms in these cases of opposition is not exactly a jurisdiction given in terms by the statute, but a jurisdiction which arises inherently from the statutory right to refuse to grant a patent, which entitles the L.O. to say "I will not grant you, the applicant, a patent unless you assent to certain terms." If I had taken a different view of the rights of *L'Oiseau & Pierrard* under s. 103 and had felt that I was in a position to refuse their grant except on certain terms, I think the opponent's argument would have been irresistible; but taking the view which I take that in the absence of *mala fides* and under the circumstances of this case *L'Oiseau & Pierrard* are entitled to have their patent ante-dated, I feel that I have no jurisdiction to impose terms which I could only justify to my mind if I had either the power to refuse the grant altogether or the power to impose what would be called equitable terms upon granting it. The opponent asks me to see that the complete is in terms and in actual words in the form of the foreign specification. I cannot impose that condition. I consider that the only privilege given is one of date, and that privilege is confined to the invention which has been made the subject of protection in the foreign country. The obligation of the applicant is to fulfil all the other conditions of the English Patent Law with reference to the specification, and therefore without saying whether the applicant's interests are endangered by inserting anything into the complete, I cannot say that there is any less obligation upon a patentee who comes and makes an application under the provisions of s. 103 than rests upon an ordinary applicant who is an English inventor.

Counsel: *Griffin* for opponents.

Agents: *Abel & Imray* for applicants; *G. F. Redfern & Co.* for opponents.

## NEWMAN, 1886, No. 3480.

*Questions an opponent may raise when a reference should be inserted.*

Application for a patent for "improvements in pneumatic door springs and checks," opposed by *Adams* on the ground that it had been patented on an application of prior date.

The C. G. allowed the patent to go on, amendments being made in the specification. The opponent appealed (10th Nov., 1887). During the argument it was suggested that the claim of invention went beyond the title and provisional.

WEBSTER, A. G., asked for any authority to show that he had power to entertain such an objection. No such authority was produced, and in his judgment the A. G. said:—If the applicant has good subject matter and the invention is not identically the same as that of the opponent the applicant is entitled to have his patent sealed though an action for infringement may be with success brought by the opponent. I am not here to stop patents at the instigation of an opponent because there is some general principle of Patent Law which is infringed. I do not decide that in no case would such a point be taken notice of. I think, however, that the L.O. might reasonably indicate to the applicant as I do now that it would be well to consider such a point, but I do not express any considered opinion that I have jurisdiction to stop a patent on some objection taken by an opponent apart from the opponent's individual rights. There is, however, one other principle which must not be lost sight of, and that is that the L.O. has always recognised that where there is an existing patent and he sees fair ground for supposing that the construction of the later specification might interfere with the rights under the existing patent, the existing patentee is entitled to protection. That is commonly done by some disclaiming clause on the face of the later specification.

The A.G. then adjourned the case to see if the parties could agree on amendments which would protect the opponent's rights, saying:—I leave entirely to the applicants the question of whether they will consider the difference between the provisional and complete. I do not consider that it is for me, and I shall not at any rate on the present occasion put any terms upon them as to the alteration of their complete on that ground.

Counsel: *Aston, Q.C.; Goodeve.*

Agents: *Skerrett; Downing.*

## VON BUCH, 1886, No. 1235.

*Described but not claimed in prior Specification—Reference.*

Application (27th Jan.) for a patent for "improvements in incandescence gas lights," opposed by the *Welsbach Incandescence Light Company, Limited*, on the ground that the invention had been patented on an application of prior date, 1885,

No. 15,286. The company were the assignees of 15,286, which was granted to *Von Welsbach* the 12th Dec., 1885, for "manufacture of an illuminant appliance for gas and other burners." The opponent's specification related to the manufacture of a cap or hood, to be placed over a burner so as to be rendered incandescent by the gas, and to enhance the illuminating power of the burner. The hood was formed of a fine cotton net fabric, saturated with chemicals, then exposed to ammonia gas and dried, and then cut into strips and folded in tubular form. One method of giving the desired shape was to draw a fine platina wire through the meshes of the net and bending the wire into a ring, to sew the edges of the fabric thus brought together with impregnated thread. The specification stated—"The hood thus formed can be supported on cross wires in the chimney of the lamp. The wire ring may be attached to a stronger wire to form a supporting stem, by which the net can be secured to a holder on the burner tube, the net itself being at such a height that the ring is an inch or more above the burner." There were no drawings. *Claim*: The manufacture substantially as herein described of an illuminant appliance for gas and other burners, consisting of a cap or hood made of fabric impregnated with the substances mentioned, and treated as set forth.

The applicant's specification stated—"My invention relates to the better construction and support of envelopes, especially fragile ones, to be rendered incandescent over a gas burner by the heat thereof. I combine with the fragile envelope or material a support or supports of platinum wire, disposed in such a way as most readily to protect the said envelope from breakage, and at the same time to provide a frame by which the envelope may be attached over the mouth of the burner. Conveniently, I may construct my support frame in a skeleton cylindrical form, so that the lower ring or projections therefrom will provide a convenient attachment to the mouth of the burner. Should the nature of the envelope be that of woven tissue, I may introduce platinum wire into the said woven material at suitable intervals in order to provide in part an indestructible support for the envelope." And, further, "The incandescent material may be supported direct to the external envelope or chimney by attaching the platinum wire through holes drilled therein." There were 8 figures and 10 claims. *Claim 1*: In incandescing gas lights the combination of the fragile envelope or incandescing material with the supports substantially as described.

The C. G. (after hearing argument) on the (17th Aug., 1887) decided to allow the patent, saying:—

The sole question in this case turns upon the point whether the words "illuminant appliance" in *Welsbach's* specification are capable of the construction sought to be put upon them by the opponents, i.e., that those words include the method which is described in *Welsbach's* specification of giving shape to and supporting the hood or cap.

If *Welsbach's* claim had ended at the word "burners," I should have held that the claim did cover such method of shaping and supporting the hood—but the claim goes on to explain what the illuminant appliance consists of, viz., a cap or hood made of fabric "impregnated with the substances mentioned and heated as set forth." Nothing is said about the method of supporting and giving shape to the hood in the claim, and in my opinion it is not claimed by *Welsbach*.

Therefore (although it appears clear that the invention for which a patent is sought is *described* in the opponent's specification) I am of opinion that the opponent's invention has not been patented (because not claimed) by *Welsbach* as alleged, and the opposition therefore fails. But in consideration of the fact that in my opinion the whole of the invention claimed by the applicant (with the exception of the subject matter of claims 8 and 9) is described in the opponent's specification, I direct that *Von Buch* shall state in his specification that his invention is for the purpose of supporting caps or hoods such as those for which a patent has been granted to *Von Welsbach*.

The C. G. approved of the insertion of the following words after "my invention" in the passage first quoted "*which is for the purpose of supporting caps or hoods such as those for which Letters Patent were granted to Von Welsbach No. 15,286 of 1885.*" Appeal to the L. O. dismissed (Jan. 12, 1888) with costs.

CLARKE, S. G.: In this case upon hearing argument on the question of fact, I came to the conclusion that the C. G. was right when he said "It appears clear that the invention for which the patent is sought is described in the opponent's specification." In the written judgment of the C. G. the word described is underlined. I understand that to mean that the invention was not merely suggested or indicated but that *Von Welsbach's* specification contains an actual description of the very matters in respect of which a patent is now claimed. I agree with the C. G. on this point. In my opinion a workman of ordinary skill and ability having before him the specification of *Von Welsbach* could and naturally would construct the very things which in his specification of later date *Von Buch* claims to have invented. The case is the same as it would have been if *Von Buch* had actually copied the whole of *Von Welsbach's* specification, and had then claimed as his invention those matters which were not included in the claiming clause of the specification he had appropriated. I have now to decide whether in this state of facts I am entitled to refuse to allow this patent of *Von Buch's* to be sealed. I find myself strictly bound and limited by the Act which gives me jurisdiction in this matter. Sec. 11 sets out the grounds and the only grounds upon which an opposition to the grant can be made. One of those grounds and that upon which alone the present opposition is founded is "that the invention has been patented in this country upon an application of prior date." Now it is a rule long established and of obvious

justice and importance that only that is patented which the inventor claims. Sec. 5 of the Act requires that a complete shall end with a distinct statement of the invention claimed. Now on referring to *Von Welsbach's* complete I find he claims—(the S. G. read the claim). I am not at liberty to speculate as to the reason of these words being chosen. They may have been used inadvertently and it may have been intended to patent the gas appliance in its fullest sense, that is to say, the mode by which the cap is supported as well as the cap itself. But the words are there: I have no power to amend them or to give them anything but their plain and direct meaning, and I must therefore hold that the invention claimed by *Von Buch* had not been patented by *Von Welsbach* and I direct the patent to be sealed.

Counsel : *Aston, Q.C., Carpmael ; Moulton, Q.C.*

Agent : *Carpmael ; Abel & Inray.*

### WARMAN, 1885, No. 8650.

*Practice where Opponent does not appear.*

Application opposed upon the ground of the invention having been previously patented. The evidence being completed notices of hearing were sent by the C. G. to the parties. On the day appointed for the hearing no one appeared on behalf of the opponent, and the C. G., after considering the case, decided in the absence of any argument in support of the opposition that the applicant's invention was not the same as the invention of the opponent. Subsequently the opponent's agent informed the C. G. that he had not received any notice of the appointment for hearing the case, and filed a declaration to that effect. The opponent was desirous of being heard, and the C. G. was asked to re-call his decision and re-hear the case.

The C. G., after reference to the minutes, found that notice of hearing was posted to the opponent's agent, and as he had given his decision upon the case he did not see how he could with justice to the applicant re-call it. He realised the hardship inflicted upon the opponent by not being able to appear owing to the miscarriage of a notice, but as they were able to appeal against the decision the hardship was somewhat mitigated. The C. G. therefore refused to re-open the case, but thought it probable if the opponent appealed the L. O. might see fit, under the circumstances, to refer the case back to him for re-hearing.

The opponent filed a notice of appeal, and the facts of the case having been brought to the notice of WEBSTER, A. G., he directed the case to be sent back to the C. G. for re-hearing.

## WOODHEAD, 1886, No. 2727.

*Costs.*

Application for a patent for "improvements in fire stoves, fenders and ash pans," opposed by *Webb* on the ground that he had a prior patent for the same invention, 1886, No. 2265. The Deputy C. G. ordered the first claim of invention to be excised and the second to be modified. The opponents, *June* 16th, 1887, appealed to the L. O. on the ground that the excision of the first claim necessitated an alteration in the first paragraph of the description. The applicants did not object to modify this, but asked that they should have their costs of the appeal, as they had not been asked to agree to the modification before the appeal.

CLARKE, S. G.—I should not think of inflicting upon you any costs with regard to anything of this kind, and I would allow you your costs at once if it were in any way the fault of the other side that this little matter should have arisen, but there appears to have been some little oversight in it, and I shall not allow costs.

Counsel : *Aston, Q.C.* ; *Chadwyck-Healey.*

Agents : *Waugh* ; *Brewer & Jensen.*

## ACTIONS FOR INFRINGEMENT.

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### BOVILL *v.* COWAN.\*

[ 1868.      Not reported.

*Prior publications—What they must state to amount to anticipation.*

Suit for infringement of a patent, 1849, No. 12,636, extended for five years (see *Goodeve, P.C.*, p. 79, where the invention is set out). ROMILLY, M.R. (30th *July*, 1867), granted an injunction and directed an enquiry as to damages. On appeal judgment affirmed (15th *July*, 1868).

CAIRNS, L.C., after stating that prior to 1849 there had been three modes of working millstones with a blast, the blast being produced in different ways and different degrees, viz.: 1. By inclosed working with an open eye and with such blast as the fanlike action of the stones would produce. 2. By inclosed working with a closed eye and with a superadded blast specially introduced near the eye. 3. Working in an airtight case with an exhaust sucking in the air along with the grain, drawing it between the stones and delivering the air and meal by means of the exhaust pump—and stating the imperfections: that the blast accumulated or condensed the air round the stones, the accumulated air being hot and clammy prevented the free delivery of the meal and injured its quality as well as filling the mill with stive in suspense, affecting the health of the workmen; and after saying that, in his view, the plaintiff's invention consisted in an exhaust just adequate to suck away the accumulation, which he terms the *plenum*, of hot air, carrying away with it and utilising the stive, leaving the meal to descend through the meal spout cool and free from clamminess, and leaving the air of the mill case of the same density as the external air, and that that was the invention *Bovill* had described, proceeded:—I have next to turn to the question of novelty. The only objections urged in this case, on the score of want of novelty, are those made in the affidavit of *Pinchbeck*, a consulting engineer, who refers to three French patents of *Vallod*, *Cartier* and *Damy*, published prior to 1849, by deposit in the British Museum. It is not suggested

\* For the notes of this case I am indebted to T. ASTRON, Esq., Q.C.



that any person, either in this country or elsewhere, was ever led by reading any of the specifications of these French patents, to adopt a process the same as the plaintiff's, and all that *Pinchbeck* says of them is that the text and drawings contain description clear and sufficient for a millwright of ordinary skill to construct and carry into effect a fit and proper means for exhausting the stive without carrying away the meal and exhausting the dusty air when the same has been blown through the grinding surfaces of the millstones, and also for passing the dust or stive through suitable porous fabrics. In one sense, I have no doubt this is the case. I think it very probable that a skilled workman if informed of the injurious effect of an unremoved *plenum* round the millstones, and desired to remove that *plenum* by an exhaust which would remove it and do nothing more, might use or adjust the machinery described in these French patents in a way that would effect that end; but the real question is, do these French patents profess to set forth as their discovery the removal of the *plenum* in this sense, and do they describe a process designed and fitted on the face of it, to attain this end? I am clearly of opinion they do not.

## BOVILL v. CRATE.\*

[1867. Not Reported.]

*Infringement of a combination—Claim to what is common property.*

Suit for infringement of the same patent. Wood, V. C., granted the relief asked (14th June, 1867).

One of the objections raised by the defendant was that the plaintiff was limited by his claim to the exhaustion of the *plenum* only when there was a superadded blast, and that as the defendant had no superadded blast he did not infringe. As to this the V. C. said: In truth, it is scarcely a part of the combination, in real substance, but supposing it to be a part of the combination, the blast is not brought forward as new, but the removal of the *plenum*, plainly and distinctly; as he says, "this part of my invention relates to that" and he claims that, and that only throughout the whole matter. Therefore he indicates distinctly what he claims; and, supposing you take this to be a combination of using the existing invention of the blast with drawing away the *plenum*, then you have no right to take that portion of the invention which will exactly effect the same thing because you can apply it to another particular form of blast. I think, perhaps, a still stronger way of construing it, which would actually establish the plaintiff's right of standing upon this patent, would be to say, that a man is not supposed to be limited to the word "combination." He has used that word undoubtedly in the early part of it. "Secondly, in exhausting the air combined with the

\* For the notes of this case I am indebted to T. Aston, Esq., Q.C.

application of the blast"—he is not to be so tied to the word "combination," when you find what he means in the part of this—I do this, when I am using a blast, and my invention is that. I do use this with an artificial blast; but if you choose to use any common blast, you are not therefore to be allowed to take my invention.

And further in commenting on *Kay v. Marshall* the V. C. said:—*Kay v. Marshall* said that if the world has got the whole thing before it, you putting in your boundary line in the midst of that which is common property, cannot mark off any part of the common which the whole world has a right to feed on; you cannot put a hedge across it and say this is something of my own which I appropriate to myself.

## BOVILL v. GOODIER.\*

[1866–1871. Not reported.]

*New result—Prior publication by documents—Experiments—Prior user—Costs.*

Suit for infringement of the same patent in which certain issues were directed by the M.R. to be tried by a jury. (See *Goodeve* P. C., p. 82.)

The invention is stated *per* CAIRNS, L. C., in *Bovill v. Cowan*, *supra*.

At the trial of these issues (8th Dec., 1866), WILLES, J., in directing the jury, after explaining how *Bovill* carried out the idea, said:—It is perfectly true as was contended on the part of the defendant that Mr. *Bovill* had no right to take out a patent for this as if it were a new idea. Whether a man puts together old elements in a way to produce some new result, or to produce an old result provided it is accompanied by conditions more favourable than were attained by the old method, it would be equally the subject of a patent. A man who takes out a patent in such a case ought to state that his patent is not for a new process but for improvements: that is what he is bound to do.

As to prior publication in certain documents, his Lordship said: With respect to documents, of course if any documents were in existence in this country before, and when I speak of this country I mean in this kingdom, which a person could get at and inform himself from so as to do what the patentee suggests that he invented—if there was a direction enabling him to do it that would anticipate the patent although no person might have taken the trouble actually to read it; if it was there as part—to use the same expression as I used before—of the sum of knowledge on the subject in the country and capable of practical application, that would do away with the novelty of the patent.

Verdict for the defendant on one issue, and the M. R. directed

\* For the notes of this case I am indebted to T. ASTON, Esq., Q.C.

a new trial on the ground that the verdict was against the evidence, WILLES, J., being also dissatisfied with the verdict.

At the second trial (11th Feb., 1868), BYLES, J., directed the jury: There may have been a great many experiments in many cases before the real thing was found out, nay sometimes what turns out to be the real thing has often been used, but only by way of experiment, and then given up. That is not an anticipation of a patent. A man must have brought his invention or his invention of a combination to a successful issue so that the thing can be done, and it must be done not as a mere experiment. Mere experiment or unsuccessful user is not an anticipation, still less is the possibility of a man doing that which he did not do not an anticipation. If he had a machine which did do the thing, and he did not do it and knew nothing about it, this being a patent for a process that is not an anticipation.

In commenting on evidence as to what had been done at certain mills prior to *Bovill's* patent, the machinery at which a witness had stated could be so worked as to exhaust the *plenum* and no more, the learned judge said:—But was it so worked? Of course it can be, because if a man has a powerful exhaust he can exhaust to a very small degree so as to produce less effect or to a larger degree to go up to the *plenum*, and go beyond it and suck up the stive to the meal spout. He may do all that, but the question here is, did they invent or even know of that precise point at which you are to stop—*plenum*, and nothing more? That they could have done it there is no doubt, and at every time the exhaust was set to work there must have been some period or other when it was done, whether they knew it or not. But this is not a patent for a machine: this is a patent for a process, and as if there be a patent for a medicine which is composed of several ingredients, and one of them is very hurtful in one dose and very beneficial in another, the amount of the dose is the very essence of the invention, so here the quantity of the air you suck up is the essence of the invention. I do not see any evidence that in these mills they confined themselves to the *plenum*, and nothing more although no doubt, they had an instrument that would do it. But then this is not a patent for the machine, this is a patent for the process. To say that there were means of regulating the exhaust is one thing; to say that they did regulate it up to a certain degree—no more, no less—is quite a different thing.

As to the French patents BYLES, J., left it to the jury to say whether they would enable a competent person to carry out the plaintiff's process, and said:—WILLES, J., in summing up, I see, said scarcely anything or very little about them. There is no reason to suppose they were not worked in France. Whether there is any previous evidence that they were, I do not know, but no person has ever seen them at work in this country. No doubt there were accounts published of them in the British

Museum, which would be sufficient to avoid this patent. Verdict for plaintiff on all the issues. ROMILLY, M. R., refused a new trial. HATHERLEY, L. C. (18th Dec., 1868), on appeal also refused a new trial, saying:—Regard being had to the evidence the direction given by the learned Judge was only such a direction as it was (if I may be allowed to say so) his duty to give in the case he had before him with reference to the materials before him, and that nothing was in any sense whatever withdrawn from the jury which was proper for their consideration.

It appeared that the plaintiff had a certificate which he obtained in a former action in which the validity of the patent came in question and application was now made for costs of the motion as between solicitor and client under s. 43 of the Patent Law Amendment Act, 1852, which enacted that the plaintiff so holding a certificate should be entitled in any subsequent action on obtaining a decree, decretal order or final judgment, to costs as between solicitor and client. HATHERLEY, L. C., held that the words decretal order and final judgment did not apply to a motion for a new trial and gave only costs as between party and party.

## BOVILL v. SMITH.\*

[1868. Not reported].

*Infringement—Less advantageous user—Construction the province of the Court.*

Suit for infringement of the same patent (see the previous cases). WOOD, V.C. (8th Nov., 1867) gave the plaintiff the relief he asked.

WOOD, V.C.: What I apprehend to have been the contest in *Bovill v. Crate* was this. The defendant, of course, was compelled to admit that in *Bovill v. Keyworth* there had been a decision on the general validity of the plaintiff's patent in that particular case; that the decision had been come to after very mature consideration; and that that consideration had been given to the case not only by CAMPBELL, C. J., who tried it, but by the Court of Q. B. on the motion for a new trial; and it appeared to me there was one very important point determined in that case, which I was not at liberty to dispute, if I had been inclined to do so, and I certainly was not inclined to dispute it. That point was just this. The decision in *Kay v. Marshall* seemed to me to raise a rather nice point upon this particular inquiry. In *Kay v. Marshall* it was determined that if it has been ascertained that an advantage is to be procured by doing a certain act, such as in that case the bringing of two parts of a machine to a nearness with each other, you could not, because you ascertained precisely the exact point at which the best effect was produced, have a special patent for that, it being known beforehand that bringing the two things near was a matter of great importance. As to that, there could have

\* For the notes of this case I am indebted to T. ASTRON, Esq., Q.C.

been a patent if they had never been used near before, but at a given distance off; but persons being at liberty to move them to any distance they pleased in the experimental process, in order to see which was the best, you could not, by alleging you had found the best number of inches to accomplish the result, on that ground alone obtain a patent. The argument, of course, upon this case of *Bovill's* patent would be, the blast having been used before, the exhaust having been used before, as you admitted by your own patent, and as, in fact, it is clear upon the evidence had been done, you cannot obtain a patent for saying, "Well, but use the blast and use the exhaust, and use them in this particular mode exactly with this amount of judgment, namely, that the *plenum* only, that is to say, the excess of blast (if I may so use the phrase) shall only be removed, and you shall take care not to work your exhaust to such an extent as to create any blast whatsoever by the stones, supposing all other blast were away." It was said you cannot have a patent for that, because that merely is hitting upon the process alone in which matter may be done, which it was admitted had been done before, but had not been done, perhaps, quite so well, because the exact line had not been hit upon. It does appear to me *Bovill v. Keyworth* distinctly decided that the patent was not open to the objection which arose in *Kay v. Marshall*, and that the patentee (as Lord CAMPBELL decided) by having described what he does, namely, exhaust the *plenum*, and having cautioned you not to do more, has made a valuable discovery, proved and established as it was in that case by evidence, and as has been proved abundantly before me by evidence in both cases of *Bovill v. Crate* and *Bovill v. Smith* to have been a vast improvement, and, therefore, a proper subject matter for a patent, inasmuch as it was not a mere idea by which parties were to be guided, but an idea brought into material action by your telling the parties what is to be done.

One test of the plaintiff about infringements is as follows,—whether or not the stive is cleared away from all parts of the machine, so that you have it in a healthy, clean state; with no heat, no dust, no waste of flour, and no nasty sour paste, and so on. That is not so in the defendant's mill—there it is not clear. The plaintiff's witnesses speak to this, and it is not contradicted, that the millstone case was quite clear, and the meal itself quite free from stive; all that had been achieved, but the plaintiff himself said nothing about the higher part of the apparatus. The higher part of the apparatus seems, from Mr. *Bramwell's* evidence, to have been clogged with paste and dust, as in the *Isleworth* case, and the thing was not sufficiently done. In the defendant's apparatus there are slides; those slides may be badly manipulated; they may not have always manipulated them to hit the right point—the right point being that you are to exhaust and do no more; but so manipulated they have been as to effect one object of the plaintiff's patent—all the stive is cleared away, and the moment

you shut the slides all the stive comes down ; so that when you make it impossible for him to use the apparatus of the plaintiff's method, then his mill is smothered with stive ; when he uses the slides in such a way that it can exactly perform what the plaintiff's does, the effect is to remove all the stive at once ; but it had not so far the effect when the practical experiment was made as to remove all the damp, and all the corrupted flour. I suppose from Mr. *Bramwell's* evidence, which I do not in any way, as I said before, question at all, it never has been used entirely effectively in that way, because he comments upon the state of the timber in the mill, which shows by indications upon it the effect of damp ; and therefore it is clear the damp could not have been wholly carried away. But the question is, whether the partial use is or is not an infringement. Now I can quite understand this, that the plaintiff is tied down to a very narrow line indeed, because that is the only way of doing the thing effectively, but when the thing is quite nicely and effectively done and will clear the whole concern, not only of the stive, but also of the damp, and the heat, sufficiently to prevent the accumulation of moisture, it is not because a person has an apparatus which, if properly used, will produce that effect through the medium of slides which will produce one object, namely, the removal of the stive, that he is to escape from his infringement : because that is done effectively, and when the slides are closed and the apparatus is not made use of, the mill is covered with dust and stive, a person cannot, by using it in that way, escape from the infringement of the patent ; that is to say simply because he does not make use of it so effectively and completely as the plaintiff does. It appears to me as regards the infringements, the apparatus is exactly that which does effect what the plaintiff does ; it does effect that portion of it to that extent if worked. If it is not worked more completely, there is no reason why he should be allowed to use one portion of the apparatus, and leave the other half unaccomplished ; he is just as much prevented by the law from using the patent to the extent which I have described, as he is from using it to the fullest and completest extent. The line to which the plaintiff is tied down is not so narrow as to allow a person to come upon the very verge of it and say "I will take just half of what you do, and I will not complete the operation, which, if carried into effect by your instrument is so very beneficial."

On appeal (7th Dec. 1868), decision affirmed.

CAIRNS, L. C., after saying he adhered to the opinion he had expressed in *Bovill v. Cowan* (*supra*), continued :—It is said the specification is not sufficient, and that there is in this case what there was not in *Bovill v. Cowan*, the evidence of scientific witnesses to show that the specification is insufficient. I desire first to express what I understand to be the province of the Court, and the province of parol testimony, the testimony of

skilled witnesses, upon the subject of specifications. The first thing a patentee has to do is to describe the nature of the invention, and when a question arises whether the invention is sufficiently described, the first thing the Court has to do is to ascertain what the invention is, because it is obvious you cannot proceed usefully to consider whether the invention is sufficiently described, unless you ascertain what the invention is. You cannot ascertain what the invention is from parol evidence from the evidence of the patentee, for he may be dead, or from the evidence of any other person; but you must proceed to ascertain what the invention is, I apprehend, from the specification, and for this purpose in the first place, in my opinion, the specification is to be construed as any other document would be construed by a court of justice, that is to say if there are terms of art used in it, they must be explained to the court—terms that have some peculiar separate construction from that which would be the ordinary construction. The Court must, if necessary, be put in possession of knowledge as to the state of the manufacture to which the patent relates at the time, and then with information of that kind the Court must address itself to find out from the four corners of the specification what the invention is. If in doing that, the Court arrives at the conclusion that the specification is unmeaning, the patent, I apprehend, is bad. If it arrives at the conclusion that, *ex facie*, part of the invention or the whole of the invention is old, it would be bad. If it arrives at the conclusion, *ex facie*, that that which is claimed as an invention is not an invention at all, the patent would be bad. If it arrives at the conclusion, *ex facie*, and from the amount of evidence to which I have already referred, that there is not sufficient discrimination in the claim between the limits of what is old and what is new, then again the patent may be bad.

But having put that construction upon it, having arrived at the construction in the way I have endeavoured to express, there is then a further operation in which the Court may engage. It may then proceed to ascertain whether the patentee has sufficiently described the manner in which the invention is to be performed, and for that purpose the Court may naturally apply for evidence to workmen, or to persons skilled in operations of a similar kind, in order to hear from them whether a workman of ordinary intelligence would be able from the directions in the specification to put the invention in operation. But then it will be seen that the Court addresses itself to that further inquiry when—and only when—it has ascertained what the invention is, the operation and practice of which is then described. . . .

Mr. *Bramwell* says the patentee claims the removal of a *plenum*, when that *plenum* has been created not merely by an artificial blast, but by the fan blast, the innate blast, as it has been termed, of the stones themselves. Well, says Mr. *Bramwell*, if that be the construction of the specification, then

I think the specification is insufficient. But why? Because, he says, there is nothing upon the face of it to show the workman when he is treading on forbidden ground. If the specification be open to the vice alleged against it by Mr. *Bramwell*, viz., that it does not show the public what is the difference between what it claims and what it does not claim; between what is new and what is old; an objection of that kind would be an objection which ought to prevail with the Court when it has ascertained what the invention is, and if it is open to that objection, the patent, in the judgment of the Court, ought to be held invalid. It is not, therefore, as it seems to me, an objection to be derived from the evidence of a skilled witness such as Mr. *Bramwell*.

## CURTIS v. PLATT.

[A full account of this suit appears in *Goodeve, P.C.*, p. 144. An imperfect note of the judgment of Wood, V.C., (6th Nov., 1863) is given at 3 Ch. D., p. 136 n. The following further extract may be found useful.]

The defendants took objection to the provisional specification as giving no outline or indication of the invention desired to be protected. As to this point, during the argument, the V.C. said:—If I had to direct a jury on it, I know nothing in any Act of Parliament which says that your provisional specification is to be final. The only thing is this, it is a very important consideration, it may be a piece of evidence to show you had not invented at the time. But if there is distinct evidence to show that you had invented at that time, then, I apprehend, however bad the provisional specification may be, it would be useless to say, if you had really invented it, that that would vitiate the patent: because there is a special clause in the Act of Parliament which says that any incompleteness in the complete specification shall vitiate the patent, but there is no such clause as to the provisional, therefore it was only intended to direct the L.O. to be very careful in getting good specifications, but it was never intended to make the provisional complete evidence. If there is a balance of evidence whether the thing was ever invented, the provisional might be very important evidence to show that it was not in the mind of the inventor at the time,

In the course of his judgment, Wood, V.C., as to the same point, said:—It appears to me that the objections on the provisional are wholly out of place as to the question of invalidating the patent, except from one very particular and narrow point of view. If you really think you have a case in which you can establish that the patentee has done a very dishonest thing, taken out his patent before he has completed his invention, and therefore was not the inventor at the time he got his patent, it may be of use to you to help you when you have other evidence tending that way; it may be of use to you to eke that out, by showing that his provisional mentions nothing at all about it,



and, therefore, you might say there is an additional probability that he knew nothing at all about it. But here I have the patentee produced; he has been cross-examined; he has fixed it as to the date, and he has sworn positively that he had completed his working model before he had applied for his patent. The fact that the provisional does not say enough is a matter for the L.O. to consider when it is laid before him, but there is nothing in the Act of Parliament which says that the patent is invalid because the provisional is insufficient. It does say, that if the complete be sufficient the patent is valid, and, therefore, I have nothing to do with the provisional beyond bearing it in my mind as a piece of evidence that can be produced to a very useful purpose upon the question I have adverted to, whether or not the invention had been made.

### SAXBY v. GLOUCESTER WAGON CO.\*

(1883. Not reported.)

The main facts of this case are sufficiently stated in *Goodere, P.C.*, 417, where judgment of the Q.B.D. appears. On appeal, the C.A. (JESSEL, M.R., BRETT, COTTON, L.J.J.) affirmed the judgment (23rd June, 1882). It is necessary to add the following passages from the report of the Official Referee:—"The same parts as are in the plaintiff's second modification, were combined by *George Edwards*, prior to the date of *Saxby's* patent (23rd Jan., 1874). A drawing of this combination of *Edwards* (No. 13) was completed by him, or under his direction, by the 30th Sept., 1873). The plaintiffs admitted that if the apparatus described in No. 13 had been published or used, it would have been an anticipation of *Saxby's* patent, but they contended there had been no publication or user. The facts bearing on the question of publication were the following:—Early in 1873 the L.N.W.R. resolved to manufacture their own apparatus for railway signalling and employed *Edwards*, who had formerly been in the plaintiff's service, to superintend the manufacture. In the course of his duties in that department, the drawing No. 13 was drafted by *Horner*, one of his clerks, under his directions. Afterwards, detailed working drawings were made by *Edwards'* clerks under his supervision. These working drawings were completed prior to October 31st, 1873, and two sets of tracings of the drawing No. 13 and working drawings were made for general use. No secrecy or concealment was imposed or observed in regard to these drawings and tracings, either with reference to the draughtsmen in *Edwards'* office, four or five in number, or to those in the offices at Crewe, 17 or 18 in number. The drawings and tracings were laid before *Webb*, the chief mechanical engineer of

\* I am indebted to W. N. LAWSON, Esq., for calling my attention to this case, and to Messrs. J. H. & J. Y. JOHNSON for the notes of the judgment of the H.L.

the L. N. W. R. Co., and they were also submitted to the locomotive committee of that company in the expectation that the combination would be adopted and used, but it was not used as *Webb* did not approve." The referee then found that a working machine was made from these drawings, not as an experimental model, but for use at a siding. "It was not, however, in fact, placed there, but was erected in the signal or pattern shop at Crewe, and tried there in its completed state. The defendants did not rely on this as user, but as proof of publication. I was of that opinion and I consider that it gave a definite character to *Edwards'* drawings as not being experimental, but finished for practical use. The plaintiffs maintained as a matter of law that there was no publication or user, inasmuch as there was a confidentiality existing among the officers and servants of the L. N. W. R. Co., and also between them and the company itself, and that this confidentiality prevented the facts from being disclosed, and when disclosed from being founded on as publication or user."

JESSEL, M. R.—The first portion of the case relates to this point, which though it seems simple is very often one of the most technical points in Patent Law, that is whether that which is an improvement of an existing machine requires invention to effect it. There are a large number of cases where the improvement is no doubt small, but it may require a considerable amount of invention to effect it, and it is of that class of cases that this is one, and it is one in which you require to hear evidence, and upon that evidence the judge says it may require invention or it may not. Now, as a rule, you only get the opinion of experts. There are only two instances to my knowledge, and Mr. Aston's knowledge, in which there ever was a workman, or supposed workman called who did it. If *Edwards* is to be treated as an ordinary workman, then his doing it is very strong evidence against the appellants. The subject matter, which, as I understand *Edwards'* evidence, he did not claim to be the result of invention or discovery, was a matter of discussion between him and *Webb*, and if it was a matter of discussion it is urged that it is not the sort of thing an ordinary workman would do. I am not satisfied about that at all. The mere fact of there being discussion as to which of two ways was preferable does not shew that either of the two was the result of invention. If an ordinary workman would do it if he were told to do it, it is not an invention according to Patent Law.

His Lordship then dealt with the evidence of the experts apart from *Edwards'* evidence, and came to the conclusion that any ordinary skilled workman would do it, and therefore that it was no invention. As to *Edwards'* evidence his Lordship said:—He does not pretend that when he had to do it it was this laborious invention of two or three years which *Saxby* talked about, but as far as this evidence goes it is a question of two or three hours. That is not

the particular thing, but to make an apparatus he knows from the 1871 patent of *Saxby* that you can combine the actuating apparatus with the locking apparatus, and then he takes what I think is the locking apparatus in *Inmray*, and combines the two. He does not pretend there was any invention at the time. He calls in a man to do it, and it is done. To my mind that is enormous evidence, and evidence that I do not ever remember to have seen before, to show it could be done without invention in the strict sense of the term; that is, invention to support a patent. His Lordship then dealt with a point not dealt with in the Court below, saying:—*Edwards* admittedly anticipated this invention, if it is an invention; for the present purpose I will assume it is. Did he publish it? If he did not publish it, but kept it secret so that it was not communicated to the public, of course it would not prevent *Saxby* taking out a valid patent, though he has in fact been anticipated. His Lordship then read the passages *supra* from the Referee's finding and said:—Now, there is nothing in the point of law. There is no conflict that the right of *Edwards* to the invention was his own personal right. The mere fact of his being the superintendent of the signalling department did not prevent him inventing and patenting a new signalling apparatus. If he obtained a patent it would not belong to the company but to himself, and if he chose to publish it to all the other 10,000 employes of the L. N. W. R. Co., of course that would have been a complete publication. He did publish it in fact to 22 or 23 of them, and in my opinion there is no pretence for saying that the publication of a secret which was his own to his fellow-servants, was less than a publication to the same individuals if they had not been his fellow-servants. The confidence of the servants is a confidence only as regards the secrets of the master, not as regards the secrets of the fellow-servants. I should be of opinion that it was not only discovered, but sufficiently published by *Edwards* before the date of the patent.

Appeal to the H.L. (SELBORNE, L.C., LORDS BLACKBURN and FITZGERALD) dismissed with costs (*June 25, 1883*), all the learned Lords agreeing with the reasons given by the M.R.

LORD BLACKBURN: If I have construed this specification rightly and have read the evidence rightly, it would seem that what Mr. *Saxby* has said is this: "I take these two old and well-known combinations, which belong to the public, and I unite them by well-known means, which every man knows, which are part of the public property; and having done that, the result is, that I am entitled to say that nobody else shall unite them in that way." That does not seem to me to be at all the kind of combination upon which a patent can be taken out.

It seems to me therefore, upon the first point, that in reality that for which *Saxby* endeavoured to take out a patent in 1874 is not a new invention which others may not use. It is, in fact, taking again what is already a part of the public benefit, and,

using it by means of well-known things, known to everyone. It is a sort of hyper-criticism, but I do not myself think that the question of a competent mechanic or an ordinary skilled workman, and the like, really comes into play at all in this case. I think that the question is really this: Are these two combinations, and the mode in which the two combinations are brought together, anything except what was known to the public before?

Then the second question is, supposing that not to be so, and supposing that what *Saxby* did in 1874 was really the subject of an invention, was it or was it not used by *Edwards* before, or by the L.N.W.R. Co., or by any of these people? Had it or had it not become a public benefit? I entirely agree with the late M.R. that the point of law which is endeavoured to be made out, namely, that the L.N.W.R. Co. had every one of their workmen and every one of their employes bound to keep secrecy and to keep their orders secret, and that consequently its being only known, as it is said (I do not inquire whether the evidence is confined to that) to employes of the company working for that company prevented its being known to the public, or being a publication, or being a public user, is no point of law at all. I quite agree with the doctrine, and I have not the slightest intention to differ from those cases which say, that where a man is trying experiments for the purpose of himself taking out a patent for an invention, all that he and his do together is confidential and if when he has made his invention complete he goes and takes out a patent all that he has done confidentially in that way does not affect him in the slightest degree. But I deny that any such doctrine applies where, as in the case of the L. N. W. R. Co., there was no idea of taking out a patent for an invention, but the object was merely to work it at their request, and when the thing was quite as unconfidential as laying down wood pavement in the portico of the gentleman's house which has been mentioned.\* I agree also that that when a thing which is said to be an invention has never come to be a complete thing, when a man has only been approximating to it, and has not yet found out how to do it, as in *Dobbs'* patent mentioned in the case of *Betts v. Menzies* he has not made the invention. But in this case the drawing was complete; it does not appear to have been actually turned into iron and wood, but the drawing was completed, and there was everything showing how the thing was to be done. *Webb* did not choose to do it, but it could have been done upon *Edwards'* drawing as completely as now, and as completely as any body could do it by reading and seeing *Saxby's* specification.

\* *Stead v. Williams, Goodeve, P.C. 437.*



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